

RECEIVED

RECEIVED
CENTRAL FAX CENTERJUL 08 2010
OFFICE OF PETITIONS

JUL 01 2010

WOMBLE
CARLYLE
SANDRIDGE
& RICE
A PROFESSIONAL LIMITED
LIABILITY COMPANY

150 Fayetteville Street
Suite 2100
Raleigh, NC 27601

Telephone: (919) 755-2100
Fax: (919) 755-2150
www.wcsr.com

Ryan W. Cagle
Direct Dial: (919) 755-8157
Direct Fax: (919) 755-6177
E-mail: rcagle@wcsr.com

VIA FACSIMILE

Please call the following number if the message you receive is incomplete or not legible: (919) 838-4168

Date: July 1, 2010	E-Mail:
Recipient: Office of Petitions	Company: U.S. Patent and Trademark Office
Fax Number: (571) 273-8300	Your Ref.:
Sender: Ryan W. Cagle (Tel: 919-755-8157)	Our Ref. :
Message:	
<p>U.S. Patent 7,264,847 Issued: September 4, 2007 Applicant: Paul D. Manos Title: LOWER ALKYL CARBOXYLIC ACID MOIETIES FOR PREVENTING OXIDATIVE CORROSION OF METALS AND ORGANOLEPTIC STABILIZER FOR FOOD AND BEVERAGES</p> <p><i>**Please see the attached Petition for Expungement of Assignment Records MPEP 323.01(d)</i></p> <p><i>**Please charge our deposit account no. 09-0528 for any additional fees.</i></p>	

Number of Pages: (including cover page)

60

CONFIDENTIAL AND PRIVILEGED: The information contained in this facsimile is privileged and confidential information intended for the sole use of the addressee. If the reader of this facsimile is not the intended recipient, or the employee or agent responsible for delivering it to the intended recipient, you are hereby notified that any dissemination, distribution or copying of this communication is strictly prohibited. If you have received this FAX in error, please immediately notify the person listed above, and return the original message by mail to the sender at the address listed above.

RECEIVED

RECEIVED
CENTRAL FAX CENTER

JUL 08 2010

JUL 01 2010

OFFICE OF PETITIONS

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

U.S. Patent No. 7,264,847

Issued: September 4, 2007

Applicant(s): Paul D. Manos

Title:

LOWER ALKYL CARBOXYLIC ACID MOIETIES FOR
PREVENTING OXIDATIVE CORROSION OF METALS AND
ORGANOLEPTIC STABILIZER FOR FOOD AND BEVERAGESMail Stop: Assignment Services Branch
P.O. Box 1450
Alexandria, VA 22313-1450**PETITION FOR EXPUNGEMENT OF
ASSIGNMENT RECORDS - MPEP §323.01(d)**

Sir:

Zannier, Inc., the rightful Assignee of the above-referenced U.S. patent, hereby petitions for expungement of an improperly filed assignment of said patent. On April 9, 2009, the United States Patent and Trademark Office recorded at Reel 022708, Frame 0688, an assignment from Robert P. Bentley, Sr. and Zannier, Inc. to Intellectual Concepts, LLC pursuant to a Judicial Order signed by District Judge G. Michael Canaday, Parish of Calcasieu, State of Louisiana. Zannier, Inc. submits that the referenced assignment is invalid and improper in form and substance in that Zannier, Inc. was never a party to the referenced judicial proceedings before Judge Canaday in the State of Louisiana as evidenced by the failure to include with the judgment any documentation that proper jurisdiction was ever established over Zannier, Inc. Zannier, Inc. points out that service of a Rule to Enforce does not establish jurisdiction. Thus, Zannier, Inc. requests expungement of the judicially decreed assignment on the grounds that the District Court of Calcasieu Parish, Louisiana, lacks proper authority to legally transfer patent ownership rights on behalf of Zannier, Inc.

In addition to the above, Zannier, Inc. submits that the underlying judgment upon which the improper assignment is based (No. 2004-2675 DIV. "G") does not provide the District Court of Calcasieu Parish, Louisiana, with authority to assign any rights in the present U.S. patent. Said judgment was based upon a finding of fact that Greg Caton, not Paul D. Manos,

RECEIVED

RECEIVED
CENTRAL FAX CENTER

JUL 01 2010

JUL 08 2010

OFFICE OF PETITIONS

U.S. Patent No. 7,264,847
Petition for Expungement of Assignment
June 29, 2010

was the sole inventor of the claimed subject matter in the subject U.S. patent applications and that only Mr. Caton has ownership rights to assign. This is contradicted by Judge Canaday's own accompanying conclusion of law that his court cannot determine inventorship. Moreover, in an Interference Proceeding before the United States Board of Patent Appeals and Interferences, the Board (a party with authority to make that determination) made a contrary ruling in relation to inventorship. Specifically, the Board ruled that Paul D. Manos was the sole inventor of the claimed subject matter. Accordingly, such ruling supersedes the contradictory ruling made by the District Court of Calcasieu Parish, Louisiana, and any purported authority upon which that court attempts to direct assignment of the present patent application is vitiated in relation to Robert P. Bentley, Sr. and Zannier, Inc., the assignees in the chain of title for the present patent.

Zannier, Inc. submits that the normal corrective procedures outlined in MPEP §323.01(a) through §323.01(c) will not provide the petitioner with adequate relief because the present error is not a typographical error that may be corrected through presentation of a corrected coversheet (§323.01 (a) or (c)) or a corrected assignment document (§ 323.01(b)). Rather, the present error arises from a directed attack on the rightful assignee, Zannier, Inc., in an attempt to improperly transfer ownership rights of an issued U.S. patent through recordation of an unsubstantiated assignment document based upon a legally flawed state court judgment, and such error may only be corrected by expungement of the improper assignment from the record.

Zannier, Inc. further submits that the integrity of the assignment records will not be negatively affected by granting the present petition. Rather, grant of the petition will preserve the integrity of the record by removing an improper assignment that arises from both a lack of jurisdiction over the rightful assignee by the Louisiana state court and the unenforceability of the Louisiana state court judgment due to preemption by the noted ruling from the U.S. Board of Patent Appeals and Interferences.

RECEIVED
CENTRAL FAX CENTER

JUL 01 2010

RECEIVED

JUL 08 2010

OFFICE OF PETITIONS

U.S. Patent No. 7,264,847
Petition for Expungement of Assignment
June 29, 2010

Accompanying the present petition are the following:

(1) The fee required under 37 C.F.R. §1.21(h) in the amount of \$40.00 is authorized to be charged to Deposit Account No. 09-0528.

(2) A Declaration from a representative of Zannier, Inc., identifying itself as the correct owner and pointing out that the judicially ordered assignment is improper.

It is not believed that any additional fees other than those specifically authorized above are required in the present petition. In the event that any additional fees are required, any such fees are hereby authorized to be charged to Deposit Account No. 09-0528.

Respectfully submitted,

/ryan w. cagle/

Ryan W. Cagle
Registration No. 47,468

Customer No. 26158
Womble Carlyle Sandridge & Rice, PLLC
Attn: Patent Docketing
P.O. Box 7037
Atlanta, GA 30357-0037
Tel Raleigh Office (919) 755-2100
Fax Raleigh Office (919) 755-2150

ELECTRONICALLY FILED USING THE EFS-WEB ELECTRONIC FILING SYSTEM OF THE UNITED STATES PATENT & TRADEMARK OFFICE ON JULY 1, 2010.

APPENDIX

Submitted with Petition for Expungement of Assignment Records MPEP 323.01(d):

U.S. Patent No. : 7,264,847
Applicant(s): Paul D. Manos
Issued: September 4, 2007
Title: LOWER ALKYL CARBOXYLIC ACID MOIETIES FOR
PREVENTING OXIDATIVE CORROSION OF METALS
AND ORGANOLEPTIC STABILIZER FOR FOOD AND
BEVERAGES

RECEIVED

JUL 08 2010
OFFICE OF PETITIONSRECEIVED
CENTRAL FAX CENTER

JUL 01 2010

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

DECLARATION OF ROBERT P. BENTLEY, SR.
ON BEHALF OF ZANNIER, INC.

I, Robert P. Bentley, Sr., hereby declare and say as follows:

1. Zannier, Inc. is the rightful owner of U.S. Patent No. 7,264,847 (hereinafter "the '847 patent") by proper chain of title from Paul D. Manos as the sole inventor of the claimed subject matter to Robert P. Bentley, Sr. and subsequently to Zannier, Inc. Assignment from Paul D. Manos to Robert P. Bentley, Sr. was effected by the document executed on September 2, 2003, and recorded on October 14, 2003 (at reel/frame 014593/0832), and the follow-up document executed on December 12, 2003 and recorded on December 16, 2003 (at reel/frame 014200/0033). Assignment from Robert P. Bentley, Sr. to Zannier, Inc. was effected by the document executed on February 7, 2008, and recorded on February 8, 2008 (at reel/frame 020484/0214).

2. The assignment from Robert P. Bentley, Sr. and Zannier, Inc. to Intellectual Concepts pursuant to the Judicial Order signed by District Judge G. Michael Canaday, Parish of Calcasieu, State of Louisiana (hereinafter "the Louisiana state court") was recorded on April 9, 2009, at reel/frame 022708/0688. This recordation is the culmination of on-going efforts by the purported assignee, Intellectual Concepts, LLC, to take ownership of patented subject matter to which the United States Board of Appeals and Patent Interferences (hereinafter "the Board") has effectively ruled it has no rights. Neither I personally nor Zannier Inc. collectively has consented to this assignment, and I declare that this assignment to Intellectual Concepts, LLC does not reflect any proper transfer of rights authorized by Zannier, Inc.

3. For many years now Intellectual Concepts, LLC has attempted to use the Louisiana state court as a tool to take ownership of the '847 patent, its predecessor

WCSR 4403240v1

application, and any related applications, and the Louisiana state court has fully obliged. In hearing the case of INTELLECTUAL CONCEPTS, LLC AND GLOBAL PRESERVATIVES, LLC VS. WONDERS OF WATER, LLC, HERBOLOGICS, LTD. AND WILLIAMS FOOD GROUP, LLC (NO. 2004-2675 DIV. "G") (hereinafter referred to as "the Louisiana state court case"), the Louisiana state court proceeded under the conclusion of law that "[the district court] cannot determine inventorship" (see the attached "Findings of Fact and Conclusions of Law" that accompanied the noted judgment, paragraph 17 of the "Conclusions of Law"). Nevertheless, in paragraph 31 of the "Facts", the district court determined that Greg Caton was "the person who conceived" the noted invention. Thus, the district court improperly determined inventorship when it properly conceded that it had no authority to do so.

4. Patent Interference 105,617 considered the matter of Intellectual Concepts, LLC (Application 10/782,405 – Junior Party) v. Zannier, Inc. (Patent 7,264,847 – Senior Party). This interference centered on the exact same subject matter as the Louisiana state court case – who was the true inventor of the subject matter in the two competing patent applications that were substantially identical in disclosure. On February 23, 2009, the Board issued Paper 87 – Memorandum Opinion and Order: Decision on the Merits. Therein, the Board determined that Paul D. Manos was the sole inventor of the subject matter claimed in the competing applications and that Mr. Manos thus was the only person with the ability to transfer ownership rights. At pages 24-29, the Board considered testimony from the Louisiana state court case upon which the district court based its inventorship determination. Having considered the same evidence before district court in the Louisiana case, the Board still determined that Paul D. Manos was the sole inventor of the subject matter claimed in the '847 patent. In light of this ruling by a party with proper authority to determine inventorship (i.e., the Board), I submit that the judicial order upon which the assignment to Intellectual Concepts, LLC was based is improper, invalid, and should be accorded no authority to transfer ownership rights in the '847 patent.

5. As noted above, the judicial order upon with the assignment to Intellectual Concepts, LLC was based related to the Louisiana state court case. Zannier, Inc., the

WCSR 4403240v1

current, proper, and rightful owner of the '847 patent is not now and never has been a party to the noted case in the Louisiana state court. Moreover, the Louisiana state court has never asserted proper jurisdiction over Zannier, Inc. in any manner or form that would vest the Louisiana state court with authority to mandate transfer of property rights held by Zannier, Inc. Thus, I submit that the assignment to Intellectual Concepts, LLC is a legally unjustified maneuver to effect transfer of property rights to which Intellectual Concepts, LLC is not entitled, as borne out by the above-discussed Memorandum Opinion and Order. Decision on the Merits issued by the Board on February 23, 2009.

6. Because of the foregoing, I submit that the assignment to Intellectual Concepts, LLC executed by Tony Mancuso, Sheriff of Calcasieu Parish, Louisiana pursuant to the judicial order by Judge G. Michael Canaday on behalf of the Louisiana state court is an improper attempt to circumvent the ruling of the Board and to overcome a lack of proper jurisdiction to act against Zannier, Inc., the rightful owner of the '847 patent. To allow the noted assignment to Intellectual Concepts, LLC to remain on the record negatively affects the integrity of the assignment records and unfairly prejudices the rightful assignee, Zannier, Inc., by holding out to the world that the '847 patent is assigned to a party with no actual rights in the patent. Thus, I fully support the accompanying request that the assignment to Intellectual Concepts, LLC be expunged from the record.

7. I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

June 25, 2010
Date

Robert P. Bentley Sr.
Robert P. Bentley, Sr., President
Zannier, Inc.

WCSR 4403240v1

JUL 01 2010

2009

AUG-17-2007 11:06 From: KM WRIGHT 3374396930 3374396730

To: 16174518313

P.2

INTELLECTUAL CONCEPTS, L.L.C.

:14th JUDICIAL DISTRICT COURT

VS. NO. 2004-2675 DIV. G

:PARISH OF CALCASIEU

WONDERS OF WATER, L.L.C.,
HERBOLOGICS, LTD., AND
WILLIAMS FOOD GROUP, L.L.C.

: STATE OF LOUISIANA

RECEIVED

JUL 08 2010

FILED: 8-17-07

Caton *Spee* OFFICE OF PETITIONS
DEPUTY CLERK OF COURTFINDINGS OF FACT AND CONCLUSIONS OF LAW

This matter proceeded to trial on the merits on June 25, 2007.

FACTS

Plaintiffs called as witnesses, Paul David Manos (by deposition), Brian Hymel, Greg Caton and Dr. Holliday Heine. After considering the Exhibits introduced and the testimony of the witnesses, the Court makes the following findings:

1.

In 2002 and 2003, Paul David Manos was a member/manager of Wonders of Water, LLC.

2.

Paul David Manos came to Lake Charles to meet with Greg Caton and was trying to sell Greg Caton a food preservative made by Wonders of Water, LLC. which it designated as RP 20.

3.

U.S. Provisional Patent Application No. 60/243,943 ("the '943 provisional") was filed with the U.S. Patent and Trademark Office ("USPTO") on October 27, 2000, disclosing an invention that was developed into the product RP 20 ("the Invention"). U.S. Utility Patent Application No. 10/055,799 ("the '799 application"), claiming priority from the '943 provisional, was filed October 25, 2001. U.S. Patent No. 6,833,087 ("the '087 patent") was issued on the '799 application on December 21, 2004.

1

Caton Exhibit 2006
Caton v. Manos
Interference 105,617

Aug-11-2007 11:06 From:KM WRIGHT 3374396930 3374396730

To:16174510313

P.3

4.

The USPTO issued Patent Number 6,833,087 (the '087 patent), from the '799 application on December 21, 2004. The '087 patent on its face shows Dr. Robert Beck and Paul David Manos as inventors and Wonders of Water, LLC and Intellectual Concepts, LLC as assignees, or owners. Robert Bentley, Jr. is not shown as an owner.

5.

The invention of the '087 patent was first disclosed publicly in the corresponding International Application No. PCT/US01/45615 ("the PCT application"), also filed on October 25, 2001 and entitled 2, 4-HEXADIENOIC ACID AND DERIVATIVES AS CORROSION INHIBITORS. The PCT application was published May 30, 2002, as WO 02/042523. The date on which its contents became part of the public domain.

When Paul David Manos came to Lake Charles to work with Greg Caton on RP 20 improvements, the composition of RP 20 was in the public domain.

Intellectual Concepts, LLC owns the rights to the food and beverage claims of Patent No. 6,833,087 and the rights of Gregory James Caton ("Greg Caton") who improved the patented formula by the addition of the preservative chemicals he had a history of using.

6.

Potassium sorbate (or a 2,4 hexadienoic acid) has been commonly used to preserve foods (see, e.g., U.S. Patent No. 6,500,360, the "Bendiner patent," and patent references cited therein).

7.

Greg Caton was affiliated with and employed by Herbologics, Ltd. in 2003, making a vegetarian product that resembled and tasted like beef jerky.

8.

2

From: KIM WRIGHT 3374396930 3374396730

To: 16174510313

P. 4

Herbologics had been using a combination of chemicals consisting of sodium benzoate and sodium propionate for many years in its vegetarian jerky.

9.

Herbologics, acquired some RP 20 from Wonders of Water, LLC to try as a preservative in its vegetarian jerky. After about a month, the RP 20 had degraded, and long string-like growths began to grow in the RP 20.

10.

In an attempt to prevent RP 20 from itself degrading, Herbologics acquired the chemicals to make RP 20, i.e., potassium sorbate and methylulose and, at one of its facilities, began to manufacture RP 20 in small amounts and add to it sodium benzoate and sodium propionate.

11.

Although Paul David Manos was around at the time of the experiments, either late 2002 or 2003, his sole contribution was the formulation of RP 20, which came into the public domain on May 30, 2002, when the PCT application was published as WO 02/042523.

12.

Greg Caton determined that a specific combination of potassium sorbate, methylelulose, sodium benzoate and sodium propionate will not degrade and will stay in solution indefinitely, and for which we now know is still effective for at least three (3) years.

13.

Paul David Manos convinced Greg Caton that they should establish a business to manufacture and sell this new product. The company to be formed was PreservX, Inc.

14.

3

FROM: KIM WRIGHT 3374396930 3374396730

To: 16174510313

P. 5

Greg Caton, Paul David Manos and Robert Bentley, Jr. agreed to form and operate PreservX, Inc. but that agreement never came to fruition, as the corporation was formed, but never capitalized.

15.

Greg Caton engaged Alston & Bird, attorneys in Charlotte, North Carolina to prepare and file a provisional patent application on the product he formulated. This application was filed on February 19, 2003 as U.S. Provisional Application No. 60/448,153 ("the '153 provisional").

16.

At Paul David Manos' request, Greg Caton allowed Paul David Manos to be listed as a co-inventor. Greg Caton was not aware of the rights that go with inventorship at the time of filing of the application.

17.

Paul David Manos, Greg Caton and Robert Bentley, Jr. had a disagreement about PreservX, Inc. and each went their separate ways.

18.

Unknown to Greg Caton, Paul David Manos had Alston & Bird file U.S. Patent Application No. 10/606,946 ("the '946 application"), which claims priority from the '153 provisional, listing Paul David Manos as the sole inventor. The '946 application was filed on June 26, 2003.

19.

Paul David Manos assigned all of his interest in the '153 provisional and the '946 application to Robert Bentley, Sr. on September 2, 2003, and the assignment is recorded in the U.S. Patent and Trademark Office.

20.

Greg Caton, in December 2003, sold the assets of the anticipated preservation business to Hodges Street Properties, LLC, and Intellectual Concepts, LLC.

AUG-17-2007 11:05 From: KM WRIGHT 3374396930 3374396730

To: 16174510313

P. 5/16

21.

In an assignment dated December 22, 2003, Greg Caton transferred to Intellectual Concepts, LLC, his interest in the '153 provisional, the invention, and in any future patent applications based on the substance of the '153 provisional. The full utility application claiming priority from the '153 provisional and designating Greg Caton as the inventor was filed on Feb. 19, 2004 as U.S. Application No. 10/782,405 ("the '405 application").

22.

Paul David Manos has acknowledged in his testimony in a deposition taken March 16, 2007 that the idea to add the sodium benzoate and the sodium propionate was Greg Caton's.

23.

The concept of the invention claimed in the '153 provisional, the '946 application, and the '405 application is the addition of lower alkyl carboxylic acid moieties to the product covered by the '087 patent, in order to prevent the patented product from degrading and/or spoiling. The evidence reflects that Greg Caton both conceived the idea of how to improve the RP 20 product, and then developed the method of making the new chemical formulation. There is no evidence that suggests Paul David Manos conceived the idea, or developed the method, of making the new chemical formula described and claimed in the '153 provisional, the '946 application and the '405 application.

24.

The Court has considered the testimony of Greg Caton and Paul David Manos as to what is the claimed invention in the '153 provisional, the '946 application and the '405 application, and the Court finds that Greg Caton is able to describe the invention with particularity whereas Paul David Manos did not describe the claimed invention, and does not appear to know all of its chemical components or how it works.

5

AUG-17-2007 11:06 From: KM WRIGHT 3374396930 3374396730

To: 16174510313

P. 7/16

25.

Greg Caton's testimony is corroborated by the testimony of Paul David Manos in his deposition and the receipts reflecting Greg Caton's long use of sodium benzoate and sodium propionate.

26.

In late fall of 2003, Herbologics began manufacturing the product described in the '405 application and the product began to be sold to Flowers Baking Corporation for a food preservative.

27.

After acquiring the assets of Herbologics, Inc., Global Preservatives, LLC continued to produce the same product, and it has continuously sold the product to Flowers through the trial date of June 25, 2007.

28.

The contribution of Paul David Manos to the claimed invention is to bring the Wonders of Water, LLC patented product to Greg Caton.

29.

Since Paul David Manos neither conceived of the idea to improve RP 20, nor developed the new formula or the process to manufacture the new formula, he can have no rights in any patent to be issued for a chemical composition described in the '153 provisional.

30.

The purported transfer by Paul David Manos to Robert Bentley, Sr. dated September 2, 2003, of his interest in the '153 provisional and the '946 application is ineffective as the Court finds as a matter of fact, Paul David Manos had no rights to ownership, and therefore has no rights to transfer.

31.

Greg Caton transferred his entire right, title and interest in the invention described in the '153 provisional to Intellectual Concepts, LLC in an assignment

6

HUG-17-2007 11:06 From: KIM WRIGHT 3374396930 3374396730

To: 16174510313

P. 8/16

executed Dec. 22, 2003 and recorded Feb. 2, 2004. On March 2, 2004, Greg Caton transferred all of his rights to the '405 application to Intellectual Concepts, LLC, said assignment being recorded July 16, 2004. The Court determines that Greg Caton is the person who conceived, formulated and manufactured the chemical formula described in the '153 provisional and the '405 application and that, therefore, Greg Caton has an interest to transfer.

32.

Paul David Manos assigned his interest in the '946 application to Robert Bentley, Sr. by an Assignment dated September 2, 2003 and recorded with the USPTO on October 14, 2003. A duplicate assignment by Paul David Manos to Robert Bentley, Sr. was executed Dec. 12, 2003 and recorded with the USPTO on Dec. 16, 2003. There are currently no other Assignments of the '946 application.

33.

Greg Caton assigned his interest in the '405 application to Intellectual Concepts, LLC by an Assignment dated March 2, 2004 and recorded with the USPTO on July 16, 2004. There are currently no other Assignments the '405 application.

34.

The conclusion of this analysis is that Intellectual Concepts, LLC is the rightful owner of any patent issued on a formula described, alternatively, as "lower alkyl carboxylic acid moieties as organoleptic stabilizers and preservatives of food and beverages and for preventing oxidative corrosion of metals" or "lower alkyl carboxylic acid moieties for preventing oxidative corrosion of metals and organoleptic stabilizer for food and beverages ", whether such patent be issued as a result of the '946 application or the '405 application. A judgment to this effect will be signed when presented.

From: KM WRIGHT 3374396930 3374396730

To: 16174510313

P. 9/16

RECEIVED

JUL 08 2010

OFFICE OF PETITIONS

CONCLUSIONS OF LAW

1.

At the heart of any ownership analysis lies the question of who first invented the subject matter at issue, because the patent right initially vests in the inventor who may then, barring any restrictions to the contrary, transfer that right to another.....*Beech Aircraft Corporation v. Edo Corporation*, 990 F.2d 1237, 26 U.S.P.Q. 2d 1572 (Fed.Cir.1993).

2.

Determining "inventorship" is nothing more than determining who conceived and reduced to practice the subject matter at issue, whether that subject matter is recited in a claim in an application or in a count in an interference. Conception, and consequently inventorship, are questions of law that are reviewed *de novo*. *Environ Products, Inc. v. Furon Company, Inc.*, 1998 WL 221033, 47 U.S.P.Q. 2d 1040 (Not Reported in F. Supp.) citing. *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1376, 231 U.S.P.Q. 81, 87 (Fed.Cir.1986); *see also In re Caveney*, 761, F.2d 671, 674, 226 U.S.P.Q. 1, 3 (Fed.Cir.1985).

3.

There are two types of inventorship contests, an originality contest and a priority contest. In an originality case, the issue is not who is the first or prior inventor, but who made the invention. *Applegate v. Scherer*, 332 F.2d 571, 141 U.S.P.Q. 796 (CCPA 1964).

4.

Conception exists when a definite and permanent idea of an operative invention, including every feature of the subject matter sought to be patented, is known. *Coleman v. Dines*, 754 F.2d 353, 359, 224 U.S.P.Q. 857, 862 (Fed.Cir.1985). Conception is complete when one of ordinary skill in the art could construct the apparatus without unduly extensive research or experimentation. *See*

From: KM WRIGHT 3374396930 3374396730

To: 16174510313

P. 10/16

Summers v. Vogel, 332 F.2d 810, 816, 141 U.S.P.Q. 816, 820 (CCPA 1964); *In re Tansel*, 253 F.2d 241, 243, 117 U.S.P.Q. 188, 189 (CCPA 1958).

5.

Conception is defined as the point in time when the inventor formed in his or her mind "a definite and permanent idea of the complete operative invention, as it is hereafter to be applied in practice," which idea is "so clearly defined in the inventor's mind that only ordinary skill would be necessary to reduce the invention to practice, without extensive research or experimentation." *Burroughs Wellcome Co. v. Barr Laboratories, Inc.*, 40 F.3d 1223, 1228, 32 U.S.P.Q.2d (BNA) 1915, 1919 (Fed.Cir.1994).

6.

Conception defines the legally operative moment of invention under § 102(g). It is the "formation in the mind of the inventor, of a definite and permanent idea of the complete and operative invention, as it is hereafter to be applied in practice." *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367 at 1376 (C.A.Fed. 1986). An idea is sufficiently definite and permanent for conception if it provides one skilled in the art with enough guidance to "understand the invention," that is, "when the inventor has a specific, settled idea, a particular solution to the problem at hand, not just a general goal or research plan he hopes to pursue." *Burroughs Wellcome Co. v. Barr Labs., Inc.*, 40 F.3d 1223, 1228 (Fed.Cir.1994). The inventor must be able to "describe his invention with particularity." *Id.* This requires both (1) the idea of the invention's structure and (2) possession of an operative method of making it. *Amgen, Inc. v. Chugai Pharm. Co.*, 927 F.2d 1200, 1206 (Fed.Cir.1991). Thus, with regard to a claimed chemical compound, conception requires that the inventor "be able to define" the compound "so as to distinguish it from other materials, and to describe how to obtain it." *Id.*

Invitrogen Corp. v. Clontech Laboratories, Inc., 429 F.3d 1052, 1063, 77 U.S.P.Q.2d (BNA) 1161, 1168 (Fed.Cir.2005).

From: KJ WRIGHT 3374396930 3374396730

To: 16174510313

P. 11/16

7.

Conception "turns on the inventor's ability to describe the invention with particularity, and the idea must be sufficiently formed so that only ordinary skill would be necessary to reduce the invention to practice, without extensive research or experimentation." *Slip Track Systems, Inc. v. Metal-Lite, Inc.*, 304 F.3d 1256, 1263, 64 U.S.P.Q.2d (BNA) 1423, 1427 (Fed.Cir.2002).

8.

Conception is separate from, and generally does not require, a reduction to practice.

Pfaff v. Wells Electronics, Inc., 525 U.S. 55, 60, 119 S. Ct. 304, 308, 142 L. Ed. 2d 261, 48 U.S.P.Q.2d (BNA) 1641, 1644 (1998).

9.

But in some instances, particularly in the unpredictable arts, such as chemistry or biotechnical gene inventions, conception cannot be found until there is a simultaneous reduction to practice. *Amgen, Inc. v. Chugai Pharmaceutical Co., Ltd.*, 927 F.2d 1200, 1206, 18 U.S.P.Q.2d (BNA) 1016, 1021 (Fed.Cir.1991).

10.

Patent issuance creates a presumption that the named inventors are the true and only inventors. See *Hess v. Advanced Cardiovascular Sys., Inc.*, 106 F.3d 976, 980, 41 U.S.P.Q.2d 1782, 1785-86 (Fed.Cir.), cert. denied, 520 U.S. 1277, 117 S.Ct. 2459, 138 L.Ed.2d 216 (1997).

11.

A patented invention may be the work of two or more joint inventors. See 35 U.S.C. § 116 (1994). Because "[c]onception is the touchstone of inventorship," each joint inventor must generally contribute to the conception of the invention. *Burroughs Wellcome Co. v. Barr Lab.*, 40 F.3d 1223, 1227-28, 32 U.S.P.Q.2d 1915, 1919 (Fed.Cir.1994). "Conception is the 'formation in the mind of the inventor, of a definite and permanent idea of the complete and operative invention, as it is hereafter to be applied in practice.'" *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*,

10

From: KM WRIGHT 3374396930 3374396730

To: 16174510313

P. 12/16

802 F.2d 1367, 1376, 231 U.S.P.Q. 81, 87 (Fed.Cir.1986) (quoting 1 *Robinson on Patents* 532 (1890)). An idea is sufficiently "definite and permanent" when "only ordinary skill would be necessary to reduce the invention to practice, without extensive research or experimentation." *Burroughs Wellcome*, 40 F.3d at 1228, (emphasis supplied)

AUG-17-2007 11:07 From: KM WRIGHT 3374396930 3374396730

To: 16174510313

P. 13/16

The conceived invention must include every feature of the subject matter claimed in the patent. See *Sewall*, 21 F.3d at 415. Nevertheless, for the conception of a joint invention, each of the joint inventors need not "make the same type or amount of contribution" to the invention. 35 U.S.C. § 116. Rather, each needs to perform only a part of the task which produces the invention. On the other hand, one does not qualify as a joint inventor by merely assisting the actual inventor after conception of the claimed invention. See *Sewall*, 21 F.3d at 416-7; *Shatterproof Glass Corp. v. Libbey-Owens Ford Co.*, 758 F.2d 613, 624, 225 U.S.P.Q. 634, 641 (Fed.Cir.1985) ("An inventor 'may use the services, ideas and aid of others in the process of perfecting his invention without losing his right to a patent.'" (quoting *Hobbs v. U.S. Atomic Energy Comm'n.*, 451 F.2d 849, 864, 171 U.S.P.Q. 713, 724 (5th Cir.1971))). One who simply provides the inventor with well-known principles or explains the state of the art without ever having "a firm and definite idea" of the claimed combination as a whole does not qualify as a joint inventor. See *Hess*, 106 F.3d at 981 (citing *O'Reilly v. Morse*, 56 U.S. (15 How.) 62, 111, 14 L.Ed. 601 (1853)). Moreover, depending on the scope of a patent's claims, one of ordinary skill in the art who simply reduced the inventor's idea to practice is not necessarily a joint inventor, even if the specification discloses that embodiment to satisfy the best mode requirement. See *Sewall*, 21 F.3d at 416.

12.

Furthermore, a co-inventor need not make a contribution to every claim of a patent. See 35 U.S.C. § 116. A contribution to one claim is enough. See *SmithKline Diagnostics, Inc. v. Helena Lab. Corp.*, 859 F.2d 878, 888, 8 U.S.P.Q.2d 1468, 1476 (Fed.Cir.1988). Thus, the critical question for joint conception is who conceived, as that term is used in the patent law, the subject matter of the claims at issue.

12

12

From: KM WRIGHT 3374396938 3374396738

To: 16174510313

P. 14/16

13.

35 U.S.C. § 256 provides that a co-inventor omitted from an issued patent may be added to the patent by a court "before which such matter is called in question." To show co-inventorship, however, the alleged co-inventor or co-inventors must prove their contribution to the conception of the claims by clear and convincing evidence. See *Hess*, 106 F.3d at 980. However, "an inventor's testimony respecting the facts surrounding a claim of derivation of priority of invention cannot, standing alone, rise to the level of clear and convincing proof." *Price v. Symsek*, 988 F.2d 1187, 1194, 26 U.S.P.Q.2d 1031, 1036 (Fed.Clr.1993). The rule is the same for an alleged co-inventor's testimony. See *Hess*, 106 F.3d at 980. Thus, an alleged co-inventor must supply evidence to corroborate his testimony. See *Price*, 988 F.2d at 1194. Whether the inventor's testimony has been sufficiently corroborated is evaluated under a "rule of reason" analysis. *Id.* at 1195. Under this analysis, "[a]n evaluation of all pertinent evidence must be made so that a sound determination of the credibility of the [alleged] inventor's story may be reached." *Id.* Corroborating evidence may take many forms. Often contemporaneous documents prepared by a putative inventor serve to corroborate an inventor's testimony. See *id.* at 1195-96. Circumstantial evidence about the inventive process may also corroborate. See *Knorr v. Pearson*, 671 F.2d 1368, 1373, 213 U.S.P.Q. 196, 200 (CCPA 1982) ("[S]ufficient circumstantial evidence of an independent nature can satisfy the corroboration rule."). Additionally, oral testimony of someone other than the alleged inventor may corroborate. See *Price*, 988 F.2d at 1195-96.

14.

The mere exercise of ordinary skill in the art does not amount to conception. Thus, if an alleged joint inventor only contributed information that was already known by one of skill in the art, the alleged joint inventor has not contributed to the

13

From: KM WRIGHT 3374396930 3374396730

To: 16174510313

P. 15/16

conception and does not qualify as a joint inventor *Caterpillar, Inc. v. Sturman Industries, Inc.*, 387 F.3d 1358, 1377-78, 73 U.S.P.Q.2d 1609 (Fed.Cir.2004).

15.

A contribution of information in the prior art cannot give rise to joint inventorship because it is not a contribution to conception. *Eli Lilly and Co. v. Aradigm Corp.*, 376 F.3d 1352, 1359, 71 U.S.P.Q.2d 1787 (Fed.Cir.2004).

16.

When the contents of the '799 application was published on May 30, 2002, as WO 02/042523, it became part of the "prior art," and the formulation of RP 20 became public domain information.

17.

This court cannot determine inventorship. 35 U.S.C. §256 gives that task to a Federal District Court after a patent is issued. However, ownership, being a State issue, allows a State Court to look at elements of inventorship when no patent has yet been issued, to determine a starting point for ownership.

18.

Declaratory relief is appropriate to determine the status of rights of the parties. *Sec Schmill v. St Charles Parish*, App. 5 Cir.1997, 96-894 (La.App. 5 Cir. 3/1/97), 692 So.2d 1161; *Parochial Employee's Retirement System of Louisiana v. Caddo Parish Com'n*, App. 1 Cir.1996, 95 0243 (La.App. 1 Cir.3/15/96), 676 So.2d 105, writ denied, 96-0955 (La.5/31/96), 673 So.2d 1031; *Gulotta v. Cutshaw*, App. 1 Cir.1972, 258 So.2d 555, writ denied, 261 La. 536, 260 So.2d 320, reversed 283 So.2d 482.

14

JUL 01 2010

msg-11-0001 11:08 From:KM WRIGHT 3374396930 3374396730

To:16174510313

P. 16/16

RECEIVED

JUL 08 2010

OFFICE OF PETITIONS

CONCLUSION

Therefore, for the reasons stated herein, Plaintiff's Petition for Declaratory Judgment is hereby GRANTED. Written judgment to be signed upon presentation.

It is so ordered, this, the 17th day of August 2007, at Lake Charles, Louisiana.

G. Michael Canaday

G. MICHAEL CANADAY
14th JUDICIAL DISTRICT COURT

15

A TRUE COPY
Lake Charles, Louisiana
8-17-07

Carol Spear
Deputy Clerk of Court
Lake Charles, Louisiana

15

JUL 01 2010

BoxInterferences@uspto.gov
Telephone: 571-272-4683

Paper 87
Entered: 23 February 2009

UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES

Patent Interference 105,617 McK
Technology Center 1700

INTELLECTUAL CONCEPTS, LLC,
(Named Inventor: Gregory James Caton)

Application 10/782,405,
Junior Party,

v.

ZANNIER, INC.,
(Named Inventor: Paul D. Manos)

Patent 7,264,847 B2,
Senior Party,

*Before: JAMES T. MOORE, Vice Chief Administrative Patent Judge,
FRED E. McKELVEY, Senior Administrative Patent Judge, and
RICHARD E. SCHAFER, Administrative Patent Judge.*

McKELVEY, Senior Administrative Patent Judge.

MEMORANDUM OPINION and ORDER
Decision on the merits

1 **A. Statement of the case**

2 What is this case all about?

3 This is not a "who was the first to invent" case involving conception,
4 actual reduction to practice, and diligence. 35 U.S.C. § 102(g)(1).

5 Rather, it is a "who done it" case, i.e., who is the inventor. 35 U.S.C.
6 § 102(f).

7 There was a time when Gregory James Caton, a/k/a Greg Caton
8 (Caton) and Paul David Manos a/k/a Dave Manos (Manos) appear to have
9 been "best buddies" or at least acted like they were best buddies—probably
10 because there was money to be had if they cooperated.

11 Something happened along the way—probably one or both thought
12 there was more money to be made if the other guy was not involved—which
13 resulted in a "falling out."

14 Caton and Manos were no longer "best buddies."

15 About the time of the "falling out," they filed a provisional application
16 which named both Manos and Caton as inventors. Provisional application
17 60/448,153, filed 19 February 2003. Ex 2001.

18 As all involved know, a provisional application has a one-year life and
19 then something else has to be done.

20 Manos moved first by filing an application (with essentially the same
21 disclosure as the provisional application). Manos application 10/606,946,
22 filed 26 June 2003 lists only Manos as an inventor. Ex 2002, page 1 et seq.

23 Manos was able to get a patent based on his application. Manos
24 patent 7,264,847 B2, issued 4 September 2007. Ex 2043.

25 The Manos patent is involved in this "interference."

1 Caton, while not moving as fast as Manos, also filed an application.
2 Caton application 10/782,405, filed 19 February 2004 lists only Caton as an
3 inventor. Ex 2038 (also Ex 1005), page 1 et seq.

4 It should be noted that the Caton application was filed just under the
5 wire, i.e., it was filed on the day the provisional application's one-year life
6 ended.

7 The Caton application is involved in this "interference."

8 Caton sought an "interference" to settle "who done it," i.e., who is the
9 inventor. A means for a putative inventor to assert inventorship rights is to
10 file a patent application and seek to have the PTO declare an interference in
11 order to establish inventorship. *Chou v. University of Chicago*, 254 F.3d
12 1347, 1358 n.2 (Fed. Cir. 2001).

13 As a result, this "interference" was declared to settle once and for all
14 "who done it."

15 The involved Caton application (10/782,405) is now owned by
16 Intellectual Concepts, LLC. Paper 9.

17 The involved Manos patent (7,264,847 B2) is now owned by Zannier,
18 Inc. Paper 13.

19 Both Caton and Manos have been accorded benefit of the
20 Caton/Manos provisional application (60/448,153).

21 When two parties are accorded the same earlier constructive reduction
22 to practice date (as occurred here), for *procedural* purposes the Board
23 designates the party (Manos) who first filed an application involved in the
24 interference as the "senior party." For *procedural* purposes of conducting
25 this interference, the second to file (Caton) an involved application is
26 designated as the "junior party." Caton therefore has been designated as the
27 junior party.

1 Manos has been designated as the senior party.

2 In the language of the oath in the Caton application, Caton maintains
3 that Caton is the "original, first, and sole inventor" of the subject matter
4 involved in this case. Intellectual Concepts, LLC Motion 2, Paper 70;
5 Ex 1006.

6 In other words, according to Caton, Caton is the sole inventor.

7 Caton recognizes that he may turn out not to be the sole inventor.

8 Caton therefore hedges his bet by requesting that if Caton is not a sole
9 inventor, then "Caton and ... Manos be declared co-inventors of the subject
10 matter ..." involved. Paper 70, page 2.

11 Manos maintains that Manos is the "original, first and sole inventor"
12 of the subject matter involved. Zannier Motion 1, Paper 57; Ex 2003,
13 page 2.

14 In other words, according to Manos, Manos is the sole inventor.

15 Like Caton, Manos "pleads" in the alternative that a judgment be
16 entered to the effect that "Manos was at least an inventor of ..." the subject
17 matter involved (Paper 57, page 1:6-7 and page 16:4-5).

18 By "at least an inventor ..." we think Manos is saying "at least a joint
19 inventor ..."

20 Requests for oral argument

21 The parties have requested oral argument.

22 Since we do not think oral argument will contribute to our
23 deliberations, the requests are denied.

The motions

The following motions are before us.

1.

Caton—"Revised" Intellectual Concepts, LLC Motion 2 (for judgment that Caton is a sole inventor). Paper 70 (a "revised" version of rejected Paper 59; see Order entered as Paper 69).

Manos—Zanier Opposition 2. Paper 68.

Caton—Intellectual Concepts, LLC Reply 2. Paper 72.

2.

Manos—Zanier Motion 1 (for judgment that Manos is a sole inventor). Paper 57.

Caton—Intellectual Concepts, LLC Opposition 1. Paper 67.

Manos—Zanier Reply 1. Paper 71.

3.

Caton—Intellectual Concepts, LLC Miscellaneous Motion 8 (to exclude Manos evidence). Paper 76.

Manos—Zanier Opposition 8. Paper 79.

Caton—Intellectual Concepts, LLC Reply 8. Paper 82.

4.

Manos—Zanier Miscellaneous Motion 3 (to exclude Caton evidence). Paper 75.

Caton—Intellectual Concepts, LLC Opposition 3. Paper 80.

Manos—Zanier Reply 3. Paper 81.

RECEIVED
CENTRAL FAX CENTER

JUL 01 2010

1 **B. The evidence**2 Manos—Zannier exhibits

3 We admit all the Manos—Zannier exhibits mentioned in (1) Manos—
4 Zannier Motion 1, (2) Caton—Intellectual Concepts Opposition 1, and
5 (3) Manos—Zannier Reply 1.

6 Caton—Intellectual Concepts exhibits

7 The presentation of the Caton—Intellectual Concepts exhibits along
8 with the Caton—Intellectual Concepts exhibit list has complicated the case.

9 The exhibit list contains exhibits not mentioned in (1) Caton—
10 Intellectual Concepts Motion 2, (2) Zannier Opposition 2, (3) Caton—
11 Intellectual Concepts Reply 2, and (4) Caton—Intellectual Concepts
12 Opposition 1.

13 The following Caton—Intellectual Concepts exhibits have been
14 properly listed in a motion, opposition or reply and are the only Caton—
15 Intellectual Concepts exhibits which will be considered, *subject to any*
16 *ruling on the Manos—Zanier motion to exclude.*

17 The exhibits subject to the Manos—Zanier motion to exclude (in
18 whole or in part) are marked with an *.

19 The exhibits which are copies of court precedent will be considered as
20 precedent, but not for establishing the facts of the case and are not listed
21 below.

22

23

24

25

26

Exhibit No	Mentioned in Caton Motion 2	Mentioned in Caton Opposition 1	Mentioned in Caton Reply 2
2004		Yes	Yes
2008	Yes		
2009	Yes		Yes
2017*	Yes	Yes	
2020			Yes
2021*	Yes	Yes	Yes
2022	Yes	Yes	Yes
2023			Y
2025			Y
2027	Yes		Yes
2031*	Yes	Yes	Yes
2036			Yes
2037	Yes	Yes	Yes
2051*	Yes	Yes	
2059	Yes		
2060	Yes		
2061*	Yes	Yes	
2062*	Yes	Yes	Yes
2063*	Yes		
2064*	Yes		
2065*	Yes		
2066	Yes	Yes	
2067*	Yes	Yes	
2069			Yes

Exhibit No	Mentioned in Caton Motion 2	Mentioned in Caton Opposition 1	Mentioned in Caton Reply 2
2070*	Yes	Yes	
2071*	Yes	Yes	
2072	Yes		
2080*	Yes	Yes	
2081*	Yes	Yes	
2082*	Yes		
2083*	Yes		Yes
2084*	Yes	Yes	
2085*	Yes	Yes	Yes
2098	Yes	Yes	Yes
2099	Yes	Yes	Yes
2100	Yes		Yes
2107			Yes
2108		Yes	Yes
2109			Yes
2110*			Yes
2111			Yes
2112*			Yes
2114			Yes
2123			Yes
2124			Yes

1 While the parties have not mentioned the following exhibits, we have
2 considered each since they relate to Caton and Manos applications or Manos
3 patents.

4

Exhibit Number	Description
1005	Caton application 10/782,405
2001	Manos and Caton Provisional application 60/448,153
2002	Manos application 10/606,946
2043	Manos Patent 7,264,847

5

6

7

C. Observation about some of the evidence

8 To say that counsel for Caton—Intellectual Concepts has not followed
9 the rules of practice in this case is an understatement. We leave it to the
10 reader to look at numerous docket entries, many of which detail "loose ends"
11 in the practice by counsel before this Board in this case.

12 Time after time the rules have been ignored by counsel for Caton—
13 Intellectual Concepts.

14 For example, counsel did not use our exhibit numbering system,
15 despite the fact that they had actual notice that Manos was to use Exhibit
16 Numbers 1001 through 1999 and Caton was to use Exhibit Numbers 2001
17 through 2999. Paper 1, page 6. Instead, counsel (both of them) used exhibit
18 numbers like Cooper 16 (Ex 2098A, page 4, line number 25). Upon
19 considering the evidence, we had no idea what Cooper 16 meant. The
20 exhibits having the "exhibit number" problem were those relied upon by
21 Caton—Intellectual Concepts, even through some of the relied upon exhibits
22 were Manos—Zannier 1000 series exhibits. Accordingly, Caton—
23 Intellectual Concepts was invited to re-file the exhibits upon which it relies

1 and cross out entries like "Cooper 18" and replace the crossed out entry with
2 a series 1000A or series 2000A exhibit number. Paper 85.

3 Notwithstanding the rules of practice violations, we have tried as hard
4 as we can to reach an informed decision on the merits in this case. It has not
5 been easy.

6 **D. Caton—Intellectual Concepts Miscellaneous Motion 8**

7 Caton—Intellectual Concepts Miscellaneous Motion 8 seeks to
8 exclude several Manos—Zannier exhibits. Paper 76.

9 In Zannier Opposition 8, "Zannier objects to IntelCon Miscellaneous
10 Motion 8 as being untimely filed." Paper 79, page 1:8-9.

11 Counsel for Zannier represents that Zannier received Motion 8 at
12 5:13 p.m. on 5 November 2008. Paper 79, page 1 n.1.

13 We have no reason to question counsel's representation.

14 The representation is consistent with the Board having received
15 Motion 8 at 5:10 p.m. on 5 November 2008.

16 In its Reply 8, Caton—Intellectual Concepts has absolutely nothing to
17 say about the Manos—Zannier observation that Motion 8 is late.

18 A paper filed electronically is due by 5:00 p.m. on its due date.
19 See (1) 37 C.F.R. § 41.106(d)(2) and (2) STANDING ORDER, ¶ 105.2.1
20 (Paper 2, page 17).

21 One would think that after the Caton-Intellectual Concepts
22 experience, as set out in Paper 65 (entered 19 September 2008), that counsel
23 for Caton-Intellectual Concepts would pay strict attention to deadlines.

24 Apparently, counsel did not get the message and again ignored a
25 deadline by filing a paper late without leave from the Board.

26 The Manos—Zannier "objection" is sustained and Caton—Intellectual
27 Concepts Miscellaneous Motion 8 is *dismissed*.

1 Notwithstanding dismissal of the motion, we will give the objected to
2 evidence such weight (including no weight) as may be warranted.

3 **E. Manos—Zannier Miscellaneous Motion 3**

4 Manos-Zannier Miscellaneous Motion 3 seeks to exclude several
5 Caton—Intellectual Concepts exhibits. Paper 75.

6 We elect not to decide Manos—Zannier Miscellaneous Motion 3 on
7 its merits.

8 First, Manos—Zannier has prevailed on the merits.

9 Second, as will become apparent, we have declined to credit much, if
10 not all, of the evidence to which an objection has been placed.

11 **F. Caton—Intellectual Concepts Motion 2 and**
12 **Manos—Zannier Motion 1**
13

14 Caton—Intellectual Concepts Motion 2 seeks entry of judgment on
15 the ground that Caton is the sole inventor of the subject matter of the count.
16 Paper 70, page 1:3-4.

17 Manos—Zannier Motion 1 seeks entry of judgment on the ground that
18 Manos is the sole inventor of the subject matter of the count. Paper 57,
19 page 1:2-4.

20 Both motions are opposed and both parties have filed replies.

21 Findings of fact

22 While neither party has the burden of proof in this particular
23 inventorship case, nevertheless a party seeking to change the *status quo* has
24 to establish a fact by a preponderance of the evidence. *Brown v. Edeler*,
25 27 CCPA 1091, 1095, 110 F.2d 858, 861 (1940).

26 A fact is established by a preponderance of the evidence when the
27 trier of facts (the Board in this case) believes that the existence of a fact is

1 more probably than its nonexistence. *Concrete Pipe & Products of*
2 *California, Inc. v. Construction Laborers Pension Trust for Southern*
3 *California*, 508 U.S. 606, 622 (1993).

4 In this case, almost every witness has "an axe to grind." Melissa
5 Pendleton is probably the only exception.

6 Both sides call the other side "liars."

7 The argument presented by both parties resembles two trains on
8 parallel tracks passing quietly in the night.

9 Any disinterested observer reading the testimony will immediately
10 appreciate the situation in which we find ourselves.

11 In this case, we have determined that it is useful to make findings in
12 generally the following order: (1) what witnesses say with citation to the
13 evidence, (2) what the provisional application and Manos patent show, with
14 citation to the evidence, and (3) a narrative on our best assessment of the
15 "story" sans citations to the evidence or case law.

16 The first time a name or abbreviation appears we use bold.

17 Paul David Manos

18 **Manos** states that he is the sole inventor named in U.S. Patent
19 7,264,847. Ex 1022, ¶ 1, page 1:2-3. This fact is one fact that can be
20 verified by a USPTO document. Ex 2043.

21 Manos has a background in the field of metals and metal preservation
22 or protection from corrosion. Ex 1022, ¶ 2, page 1:6-7.

23 He indicates that he has many years of experience in the
24 electrodeposition industry. Ex 1022, ¶ 2, page 1:7-8 (direct); Ex 2107A,
25 page 6:24 through page 7:8 (cross).

26 At one time, and before he attended college, Manos worked at
27 **Perfection Industries**, which Manos characterizes as a precision tooling

1 company. Ex 1022, ¶ 2, page 1:8-9 (direct); Ex 2107A, page 7:16 through
2 page 8:3 (cross).

3 In 2001 and 2002, Manos worked with **Wonders of Water, LLC**.
4 Ex 1022, ¶ 3, page 1:10-11.

5 Wonders of Water sometimes is referred to in the record as **WOW** or
6 **W.O.W.**

7 Apparently, Manos was a "managing member" (whatever that means)
8 of **WOW**. Ex 1022, ¶ 3, page 1:12.

9 According to Manos, while at **WOW** he worked on research and
10 development of metal preservatives and anticorrosives. Ex 1022, ¶ 3,
11 page 11-12.

12 While working at **WOW**, Manos says he co-developed along with
13 **Dr. Robert Beck**, a metal anticorrosive agent known as **RP-20** for corrosion
14 protection on metals. Ex 1022, ¶ 5, page 1:18-19 (direct); Ex 2107A,
15 page 11:13-22 (cross).

16 **RP-20** was developed "using food-safe materials." Ex 1022, ¶ 5,
17 page 1:19-20 (direct); Ex 2107A, page 11:22 through page 12:6 (cross).

18 According to Manos, **RP-20** was "independently evaluated by
19 **Metallurgical Problem Solving, Inc.**" Ex 1022, ¶ 5, page 1:20 through
20 page 2:2.

21 **Metallurgical Problem Solving, Inc.** is also referred to in the record as
22 **MPSI** or **Mpsi**.

23 A document styled "Executive Summary of Overall Evaluation of
24 **Wonders of Water Rust Preventative Product: RP-20; (Mpsi Evaluation**
25 **#5459)** appears in the record as Ex 1011.

26 The document is dated 3 December 2001 and is addressed to Dave
27 Manos. Ex 1011, page 1.

1 The important results of a series of immersion tests are described at
2 page 2, paragraphs (1), (2) and (3).

3 A conclusion by MPSI is that "[i]n over 20 years of corrosion
4 protection experience, we have never seen a product that offers this level of
5 corrosion protection that is water based, non-toxic, and easily removed from
6 the component's surface for subsequent processing." Ex 1011, page 3, under
7 CONCLUSIONS.

8 On 25 October 2001, a Manos and Beck application 10/055,799 was
9 filed. Ex 1010, page 1.

10 The Manos and Beck application matured into Manos and Beck
11 U.S. Patent 6,833,087 B2 on 21 December 2004. Ex 1010.

12 In connection with the Manos and Beck application, Manos "worked
13 with Dr. Beck and a patent attorney, **Holly Heine**." Ex 2020A, page 7:2-9
14 (discovery deposition). See also Ex 1010, page 1, item (74) identifying the
15 attorney, agent or firm.

16 Heine is now adverse to Manos since she is the lead attorney for
17 Caton—Intellectual Concepts in this proceeding.

18 According to Manos, the Manos and Beck patent relates to RP-20
19 calling attention to Ex 1010, col. 22:56-64—"Formulation Coatings" and a
20 composition having (1) potassium sorbate, (2) polyethylene glycol 8000 and
21 (3) water. Ex 2107A, page 12:15 through page 13:23 (cross). See also
22 Ex 2020A, page 21:18 through page 22:5 (discovery deposition) and
23 Ex 2099A, page 15:7-11 (cross resumed).

24 Potassium sorbate is a 2,4-trans,trans-hexadienoic anion. Ex 2059,
25 page 4:31 through page 5:2.

26 Manos refers to Carbowax 8000—which is probably polyethylene
27 glycol 8000. Ex 2107A, page 13:24 through page 14:9 (cross).

1 Manos indicated that "[i]t works a little better" if you hydrate
2 the polyethylene glycol (which comes in powder form). Ex 2107A,
3 page 14:10-21 (cross).

4 In September of 2002, WOW is said to have run into financial
5 difficulties and began closing down its "limited research facilities."
6 Ex 1022, ¶ 6, page 2:5-6 (direct).

7 By financial difficulties, Manos means "out of money." Ex 2107A,
8 page 24:5.

9 Manos therefore began looking for further work opportunities.
10 Ex 1022, ¶ 6, page 2:6-7.

11 Manos says that prior to September of 2002, he had purchased
12 chemicals "from Greg Caton's business." Ex 1022, ¶ 7, page 2:8-9.

13 At some point, Manos briefly corresponded with Caton "regarding
14 doing research for food preservatives." Ex 1022, ¶ 7, page 2:9-10.

15 In what we believe to be the September/October 2002 time-frame,
16 Caton is said to have been having molding problems in Caton's Lumen
17 Foods business. Ex 1022, ¶ 7, page 10-11. By "molding problems" we
18 believe Manos is referring to "mold" problems—mold getting into food
19 products.

20 Up to the October 2002 time-frame, Manos says he declined to work
21 in the food area because his focus is said to have been on metals. Ex 1022,
22 ¶ 7, page 2:11-12.

23 However, "the downturn at WOW" caused Manos to reconsider.
24 Ex 1002, ¶ 7, page 2:12.

25 Manos and Caton had a discussion and as a result Manos "agreed to
26 meet with ... Caton for the purpose of solving his molding problem."
27 Ex 1022, ¶ 7, page 2:13.

1 On 16 October 2002, Caton arranged for Manos to fly to Lake
2 Charles, Louisiana. Ex 1022, ¶ 8, page 2:14 (direct); Ex 2107A, page 15:22
3 through page 16:22 (cross).

4 Lumen Foods is located in Lake Charles and, as we understand it, is
5 the company where Caton worked. Ex 1022, ¶ 8, page 2:14-15.

6 Manos invited "a longtime friend", Robert Bentley, Jr., ("Bentley")
7 to join Manos in Lake Charles. Ex 1022, ¶ 8, page 2:15-16.

8 The reader needs to be aware that a Robert Bentley, Sr., is also
9 mentioned in the record, but he did not testify in connection with the
10 motions under consideration.

11 Apparently Manos thought that "a possible business venture" might
12 come out of the visit to Lake Charles and Manos further thought Bentley
13 might be interested in investing in the business venture. Ex 1022, ¶ 8,
14 page 2:16-18.

15 Bentley joined Manos in Lake Charles on 17 October 2002. Ex 1022,
16 ¶ 8, page 2:18-19 (direct); Ex 2107A, page 16: 17-19 (cross).

17 Manos took some methylcellulose to Lake Charles. Ex 1022, ¶ 9,
18 page 3:2-4 (direct); Ex 2107A, page 16:23 through page 17:22 (cross).

19 Manos had used methylcellulose in food preservatives despite his
20 avowed primary interest in metal corrosion prevention. Ex 2111,
21 page 1:1-7.

22 From 17 October 2002 through 19 October 2002, Manos used "a
23 variety of commercially available chemicals in stock at Lumen Food" along
24 with other chemicals Manos brought to Lake Charles "to prepare a variety of
25 stabilized preservative formulations." Ex 1022, ¶ 9, page 3:1-4 (direct);
26 Ex 2107A, page 18:7-11 (cross).

1 The chemicals, which are referred to in the record as "powders," were
2 given to Manos at Lumen Foods by **John Houston** (now deceased).
3 Ex 2107A, page 18:7-11.

4 Manos believes that Lumen Food was using a preservative product
5 having (1) potassium sorbate, (2) sodium propanate [sic—sodium
6 propionate] and (3) "benzoate." Ex 2031, page 102:11-13 (trial testimony
7 from *Intellectual Concepts v. Wonders of Water*, Civil Suite 2004-2675-G
8 (14th Judicial District Court, Calcasieu, Louisiana)—Caton acting *pro se*
9 questioning Manos.

10 One stabilized preservative formulation is said to have included
11 sodium propionate. Ex 1022, ¶ 9, page 3:4-6.

12 According to Manos, the ability to use the formulations in
13 preservation methods may be dependent on the method for preparing the
14 formulations. Ex 1022, ¶ 9, page 3:6-8.

15 Further according to Manos, "it was necessary to form a hydrated
16 polymer composition to which further components, such as the propionates,
17 could be added." Ex 1022, ¶ 9, page 3:8-10. By "hydrated polymer" we
18 think Manos refers to polyethylene glycol, e.g., Carbowax 8000 and the like.

19 Still further according to Manos, "the further components were
20 preferably added to the hydrated polymer as a concentrate." Ex 1022, ¶ 9,
21 page 3:10-12.

22 Manos says he may have made notes concerning the formulations, but
23 the notes are no longer in his possession. Ex 1022, ¶ 9, page 3:12-15.

24 The "new formulations" are said to have "provided the stability to
25 solve the [Caton] molding problems." Manos insists that he advised Caton
26 of "my results." Ex 1022, ¶ 9, page 3:15-17.

1 While working on the preservative formulation, Manos says that
2 on 17 October 2002 he came up with the idea that the formulations would
3 be useful in methods of preventing corrosion on metals. Ex 1022, ¶ 10,
4 page 3:18 through page 4:3.

5 On 19 October 2002, Manos left Lake Charles and returned to his
6 home in Pinchurst, North Carolina. Ex 1022, ¶ 11, page 4:4-5.

7 To test his "theories around metal anticorrosion", Manos "took
8 samples of several of the chemical powders ... [he] had been using in
9 developing a food preservative at Lumen Foods (including propionate
10 powders), and ... [he says he] used the chemicals to perform anticorrosive
11 testing." Ex 1022, ¶ 11, page 4:5-8 (direct). See also Ex 2107A,
12 page 18:12-23 (cross).

13 The powders included potassium sorbate, sodium propionate, and a
14 benzoate. Ex 2107A, page 18:21-22. The "benzoate" was probably sodium
15 benzoate.

16 From 20 October 2002 through 23 October 2002, Manos says his
17 experimental work "confirmed that formulations including propionates were
18 useful to prevent corrosion of metals." Ex 1022, ¶ 12, page 4:16-17.

19 It was not Manos' "practice at that time to maintain a formal invention
20 notebook documenting the tests." Ex 1022, ¶ 12, page 4:17-18.

21 Contradicting himself on cross, Manos says there were "some records
22 of those tests" but he does not know where the record are "today" although
23 they might be at Thermal Metal. Ex 2107A, page 19:7 through page 20:5.

24 Thermal Metal appears to have been a WOW customer. Ex 2107A,
25 page 24:8-10 (cross); Ex 2099A, page 15:8 through page 16:6 (cross
26 resumed). The bottom line: there is no contemporaneous documentation
27 recording the 20-23 October 2002 Manos experiments.

1 Having confirmed his theories, Manos contacted Bentley and Caton,
2 probably by phone. Ex 1022, ¶ 13, page 4:19-20 (direct); Ex 2107A,
3 page 20:6-19 (cross).

4 According to Manos, Caton was only interested in the food business.
5 Ex 1022, ¶ 12, page 4:20 through page 5:1.

6 Notwithstanding Caton's alleged expression of interest only in the
7 food business, Manos, Bentley and Caton nevertheless agreed to pursue a
8 business venture "centered around ... [the Manos] discover[y]." Ex 1022,
9 ¶ 13, page 5:1-3.

10 On or about 13 November 2002, all three signed a "Letter of Intent."
11 Ex 1022, ¶ 13, page 5:3-4; Ex 1007.

12 According to the "Letter of Intent", the Manos, Bentley and Caton
13 roles were as follows:

14 (1) Paul "Dave" Manos was referred to as "Inventor" (Ex 1007,
15 page 2), who expressed an interest in being "employed in the field of
16 industrial preservation solvents" (Ex 1007, page 1, first paragraph; see
17 also Ex 2107A, page 30:14-22 (redirect)).

18 (2) Greg Caton was identified as associated with **Herbologics,**
19 **Ltd.** (Ex 1007, page 2), a Louisiana manufacturing company wishing to
20 manufacture products that make use of the "Inventor's technology" (Ex
21 1007, page 1, third paragraph; see also Ex 2107A, page 30:18-19 (redirect)).

22 (3) Robert Bentley (we believe Robert Bentley is Robert
23 Bentley, Jr.) was referred to as "Investor" (Ex 1007, page 2) associated with
24 **Zanier** [sic—Zannier ?] **Consultants** who wished "to invest in a
25 commercial entity that makes use of the technology that the Inventor is
26 currently developing" (Ex 1007, page 1, second paragraph; see also
27 Ex 2107A, page 30:19-21 (redirect)).

1 A review of the "Letter of Intent" reveals that Herbologics, Ltd.,
2 created a "new" Nevada corporation called **PerservX** to "research, patent,
3 manufacture and market new products that come of the Inventor's
4 technology." Ex 1007, page 1, fifth paragraph. See also Ex 1022, ¶ 13:1-7.

5 On cross, Manos agreed that the "Letter of Intent" identifies Manos as
6 the "Inventor" and not a sole inventor. Ex 2107A, page 21:10-15.

7 What is clear is that the "Letter of Intent" does not identify Caton as
8 an inventor. As Manos testified on cross, he is the only individual identified
9 in the "Letter of Intent" as an inventor. Ex 2107A, page 22:5-9.

10 On cross, Manos also agreed that the "Letter of Intent" did not identify
11 the "exact [Manos] technology." Ex 2107A, page 22:10-15.

12 On or about 19 November 2001, Manos says he contacted the law
13 firm of Alston & Bird to discuss preparation of a patent application "around
14 my new discovery." Ex 1022, ¶ 14, page 5:8-9.

15 Manos says he spoke with **Jason Cooper**. Ex 1022, ¶ 14, page 5:10.

16 As will become apparent, Cooper is a registered patent attorney
17 associated with Alston & Bird.

18 Manos now seems to understand that Alston & Bird was retained by
19 **PreservX**. Ex 1022, ¶ 14, page 5:11-13.

20 Manos corresponded "multiple times" with Cooper and **Melissa**
21 **Pendleton**, another registered patent attorney associated with Alston & Bird.
22 Ex 1022, ¶ 15, page 5:14-15 (direct); Ex 2107A, page 24:14 through
23 page 25:1.

24 On 10 February 2003, Manos provided at least two faxes to
25 Pendleton. Ex 1022, ¶ 15, page 5:17-20 (direct); Ex 2099A, page 6:11-14
26 (cross)).

1 The faxes appear to have been received at Alton & Bird on
2 12 February 2003.

3 A first fax (Ex 1012) is a Technical Overview of RP-20, the product
4 sold by WOW. According to the Overview, RP-20 (identified as a
5 "proprietary antioxidant") is environmentally safe. Reference is made to a
6 MPSI probe. Ex 1012, page 1, last paragraph. Polymer/glocols are
7 identified as having "terrific applications in metal finishing, plating,
8 metalworking, release agents and many other areas since the 1940s."
9 Ex 1012, page 2, third full paragraph. The "polymer/glycols" are also
10 referred to in the record as "peg" (polyethylene glycols). But, the
11 polymer/glycols have problems which are said to solved by reformulating
12 the polymer/glocols to contain the "proprietary antioxidant." Ex 1012,
13 page 2, last paragraph.

14 A second fax (Ex 1013) appears to provide information on Food and
15 Drug Administration (FDA) regulations, which Manos probably retrieved
16 from the FDA Internet web-site on or about 10 February 2003. Ex 2107A,
17 page 25:23 through page 26:7.

18 Manos indicates that Manos and Caton provisional application
19 60/448,153 was filed on 19 February 2003. Ex 1022, ¶ 16, page 6:1-2
20 (direct); Ex 2107, page 8:19 through page 9:19 (cross).

21 Manos and Caton are listed as inventors in the Manos and Caton
22 provisional application. Ex 2001, pages 1 and 3.

23 More about the content of the Manos and Caton provisional
24 application appears later in this opinion.

25 On 26 June 2003, Manos filed Manos application 10/606,946 and
26 claimed priority to the provisional application. Ex 1022, ¶ 17.

1 The oath in the Manos applications alleges that Manos is the "original,
2 first, and sole" inventor. Ex 2003, page 2.

3 Manos U.S. Patent 7,264,847 (based on the Manos application) issued
4 on 4 September 2007. Ex 2043.

5 More about the content of the Manos patent appears later in this
6 opinion.

7 Getting back to PreservX, there appears to have come a time when
8 PreservX marketed some food preservative products, one of which was
9 SG150. Ex 2031, page 103:21-24.

10 The ingredients of SG150 are said to have been (1) methylcellulose,
11 (2) potassium sorbate, (3) sodium benzoate, and (4) sodium propionate.
12 Ex 2031, page 107:2-7.

13 Manos explains the difference between RP-20 and SG150 by
14 indicating that RP-20 uses Carbowax 8000 while SG150 uses
15 methylcellulose. Ex 2031, page 108:19 through page 109:14.

16 Manos agrees that it was Caton's idea to use add sodium propionate to
17 make SG150. Ex 2031, page 109:15-23.

18 Manos has never agreed that it was Caton's idea to add
19 methylcellulose to any mixture of chemicals used by Caton at Lumen Foods
20 or PreservX to preserve food.

21 Gregory James Caton

22 After Manos filed the Manos application on 26 June 2003 (Ex 2043),
23 on 19 February 2004, Caton filed Caton application 10/782,045 (Ex 2038).

24 The Caton application was filed by Heine, who it will be recalled
25 represented Manos and Beck in connection with the Manos and Beck
26 application.

27 Caton eventually got around to filing an oath. Ex 1006.

1 The oath alleges that Caton is the original, first and sole inventor of
2 the subject matter of the Caton application. Ex 1006.

3 There came a time when Caton presented claims which are essentially
4 the same as the Manos patent claims and asked the USPTO to solve an
5 inventorship issue—who is the inventor? Caton or Manos?

6 In an inventorship contest before the Board, ordinarily one would
7 expect Caton (1) to present direct declaration testimony which (2) would be
8 followed by cross-examination.

9 Caton—Intellectual Concepts tried step (1)—it presented the direct
10 declaration testimony of Caton.

11 However, Caton—now a resident of Ecuador—declined to come to
12 the United States for cross-examination as required by the rules.

13 Caton—Intellectual Concepts moved *in limine* to have the Caton
14 declaration admitted without cross-examination in the United States.

15 The motion *in limine* was opposed by Manos—Zannier and was
16 denied by the Board.

17 For the complete details surrounding the *in limine* event, the reader is
18 referred to Paper 66 entered 19 September 2008.

19 In a nutshell, in 2004 Caton pleaded guilty to a Bill of Information
20 filed by U.S. Attorney in the Western District of Louisiana. Caton was
21 sentenced to 33 months and served "the time" minus any good behavior,
22 there being no parole in the Federal system. However, Caton was also
23 required to serve a 3-year period of supervised release. Caton took off for
24 Ecuador. In order to complete supervised release, from time to time Caton
25 had to visit the "Supervised Release Officer." Based on an alleged illness,
26 Caton asserted he could not fly back to Louisiana for the "visit." This got

1 Caton in a lot of potential trouble. Caton said that if he came back to the
2 United States, he might be arrested.

3 There is no direct testimony by Caton or cross-examination of Caton
4 in the usual sense.

5 Instead, Caton—Intellectual Concepts relies on testimony by Caton in
6 *Intellectual Concepts v. Wonders of Water*, Civil Suite 2004-2675-G (14th
7 Judicial District Court, Calcasieu, Louisiana. Ex 2036.

8 Although it is a matter in dispute in this case, it is not entirely
9 absolutely clear that inventorship was an issue before the Louisiana court.
10 See the discussion on page 18 of Paper 65 (Memorandum Opinion and
11 Order denying Intellectual Concepts Motion 6).

12 Therefore, there may not have been an opportunity to adequately
13 cross-examine on the inventorship issue.

14 Nevertheless, since we rule against Caton—Intellectual Concepts, we
15 will make some findings based on the testimony.

16 The Caton Louisiana court testimony took place on or about 25 June
17 2007, apparently after Caton got out of the slammer, i.e., was released from
18 Federal custody.

19 We do not know whether Caton was residing in Ecuador at the time
20 and came back to testify or whether he had not yet relocated to Ecuador.

21 An index of the testimony appears on page 3 of Ex 2036.

22 As is apparent, the Caton testimony begins at page 40 and ends at
23 about page 159.

24 Only part of the Caton testimony is relied upon by Caton—Intellectual
25 Concepts.

1 The Caton testimony that is relied upon starts on page 83, which is
2 direct examination by Mr. Wright, counsel for Intellectual Concepts
3 (Ex 2036, page 3).

4 There came a time when Caton had discussions with Manos.
5 Ex 2036, page 83:8-16.

6 It seems that Caton—actually Lumen Food—was using RP-20 as a
7 food preservative. The RP-20 was bought from WOW, but the RP-20 was
8 said to be degrading. Ex 2036, page 83:13-16.

9 When asked if he thought Manos knew what he was doing
10 (scientifically we would assume), Caton essentially said "no way" (our
11 words). Ex 2036, page 85:28 through page 86:3. See also Ex 2036,
12 page 92:26 through page 93:1, where Caton says everything Manos learned
13 about potassium sorbate and sodium benzoate Manos learned from Caton.

14 Eventually, Caton talked with Manos and advised that Caton had a
15 "mold outbreak" in the Lumen Foods product. Ex 2036, page 86:10-14.

16 Mold in a food product is not acceptable. Ex 2036, page 86:12-14.

17 As discussed above, RP-20 is a mixture in water of potassium sorbate
18 and polyethylene glycol 8000.

19 Answering a leading question, Caton says that he came up with an
20 idea to add sodium propionate and sodium benzoate to RP-20. Ex 2036,
21 page 88, page 25-28.

22 After some non-responsive testimony, Caton states that "[a]ll we did
23 was take the formula that Lumen Foods was [al]ready using and put in the
24 methylcell[ulose] base that I only later was to learn that Manos had taken
25 from his workings with W.O.W." Ex 2036, page 89:31 through page 90:2.

26 With apparent reference to the Manos-Caton 2002 October meeting at
27 Lumen Foods, Caton recalls how the "formulation" which solved his mold

1 problem came about. Ex 2036, page 90:3-12. Caton does not mention
2 whether Bentley was present, but does mention Houston.

3 When asked "What did Manos contribute to the product?", Caton had
4 no trouble answering "[t]he use of methylcellulose." Ex 2036, page 15-16.
5 See also Paper 70, page 8:10-11: "Mr. Manos provided the methylcellulose
6 for the new preservative formulation ..."

7 Based on other evidence in the record, it is apparent that Canton
8 viewed the use of methylcellulose as significant. "What is central to our
9 ["our" probably means PreservX] invention, and how it differs from [U.S.
10 Patent] 6,248,700 [, a patent apparently found in a pre-application search by
11 Alston & Bird,] is that the use of the methylcellulose brings out properties
12 that are not inherent to proprionic [sic—propionic] acid, used by itself ..."
13 Ex 2022, unnumbered page 6—Caton email to Cooper dated 11 December
14 2002 at 6:05 P.M.

15 Caton claims to have added the sodium propionate and sodium
16 benzoate to the RP-20 mixture. Ex 2036, page 90:19-26.

17 Caton understands that methylcellulose is present in RP-20. Ex 2036,
18 page 90:16-18. See also Ex 2035, page 9:9-15.

19 Caton agrees that there was an effort to create PreservX. Ex 2036,
20 page 90:27-31.

21 Caton agrees that Alston & Bird were retained to get a patent on this
22 "new product." Ex 2036, page 90:32 through page 91:8. Pages 2-4 of
23 Ex 2022 tend to confirm that Alston & Bird were retained by PreservX.

24 Caton claims that Herbologics paid for the patent application
25 preparation fees—at least initially. Ex 2036, page 91:11-16.

1 Caton recognizes that a provisional patent application was filed and
2 that the provisional application names Manos and Caton as inventors.
3 Ex 2036, page 91:20-24.

4 According to Caton, Manos was named as an inventor because
5 "Manos insisted on it." Ex 2036, page 91:28. We note that the Caton
6 "insisted on it" testimony survived a hearsay objection before the Louisiana
7 court.

8 Nevertheless, when asked if he understood the implication of Manos
9 being a co-inventor, Caton testified "I don't know and I didn't care."
10 Ex 2036, page 92:12.

11 Cross-examination began with exactly what one would expect—an
12 attack on credibility: "Have you been convicted of a crime" to which the
13 answer had to be "Yes." Ex 2036, page 96:14-16.

14 At this point, we learn that Caton was in prison for 26 months.
15 Ex 2036, page 96:28.

16 The "jail time" incident was followed by a discussion of a libel suit
17 brought against Caton which the Louisiana court allowed in evidence as
18 going to the credibility of Caton. Ex 2036, page 96:29 through page 97:26.

19 Apparently the libel plaintiff was awarded \$10,000,000, which Caton
20 was unsuccessful in avoiding through bankruptcy proceedings. Ex 2036,
21 page 97:21 through page 98:10; *Matter of Caton*, 157 F.3d 1026 (5th Cir.
22 1998).

23 The record does not reveal whether the judgment was paid. Anyone
24 reading this record could assume it was not, but it is not apparent why
25 payment or non-payment of the judgment is relevant.

26 The libel incident demonstrates a possibility that Caton "lied" once
27 before.

1 Like Manos, Caton apparently took some college courses and
2 obtained an Associate of Art Degree in Social Sciences. Ex 2036,
3 page 98:18-26.

4 Caton states that it was Herbologics that retained Alston & Bird to file
5 the Manos and Caton provisional application. Ex 2036, page 100:8-11.

6 As to whether Alston & Bird was retained by PreservX, Caton says
7 "Yes and No." Ex 2036, page 100:31 through page 101:2.

8 As far as Caton was concerned, PreservX was not yet an ongoing
9 company and therefore Alston & Bird was paid by Herbologics. Ex 2036,
10 page 101:12-17.

11 Caton agrees that Manos, Bentley, Jr. and Caton agreed to form
12 PreservX. Ex 2036, page 103:22-24.

13 Caton further agrees that the reason for forming PreservX was to
14 market the "new product". Ex 2036, page 104:13-14.

15 The "new product" was believed by Caton to be that described in the
16 Manos and Caton provisional application. Ex 2036, page 104:20-26.

17 While Caton agrees that the "Letter of Intent" indicates that Bentley
18 was to invest in PreservX, according to Caton, Bentley never "invest[ed] as
19 much as one penny in PreservX." Ex 2036, page 105:21-23.

20 There was a discussion about a product identified as SG200, said to
21 have been manufactured by Herbologics for PreservX. Ex 2036, page
22 106:8-12.

23 Caton went on to say that Caton never told Manos of the SG200
24 formula and that it is not covered by the patent. Ex 2036, page 106:13-22.

25 Caton identifies Bentley Exhibit 3 (at trial) as the "Letter of Intent."
26 We believe that the "Letter of Intent" is Ex 1007.

1 Caton agrees that he signed the "Letter of Intent." Ex 2036,
2 page 107:27-28.

3 Caton further agrees that Bentley was the "investor." Ex 2036,
4 page 108:7-9.

5 An attempt was made on cross-examination to establish the products
6 covered by the "Letter of Intent." Ex 2036, page 113:28 through page 114:1.

7 According to Caton, "[t]hat was one of a whole smorgasbord" but that
8 "it" was one of them. Ex 2036, page 114:3-7. We are not sure what "it"
9 means.

10 Whatever "it" may be, Caton says the provisional application was an
11 attempt to cover "it." Ex 2036, page 114: 18-28.

12 In discussion between counsel and the Louisiana court on an objection
13 to admissibility of evidence, Mr. Upton (the attorney cross-examining
14 Caton) stated the following. "I thought his testimony this morning was that
15 he came up with the idea and he invented it, not Paul Davis Manos."
16 Ex 2036, page 115:4-6. Interjecting himself into the discussion between
17 counsel and the court, Caton stated: "I never said that."

18 A final observation about the trial testimony will be to point out that it
19 would not be unfair to characterize Caton as a combative witness. On
20 various occasions, Caton interjected himself into discussion between counsel
21 and the court and on other occasions the court appeared to "calm" (our
22 words) Caton down. See, e.g.: Ex 2036 (1) page 102:22-26, (2) page
23 109:26-31; (3) page 110:4-10; (4) page 111:21-24; and (5) page 115:3-8.
24 Caton's behavior at trial does not establish confidence that he was an
25 "objective" witness.

1 Robert Bentley, Jr.

2 Bentley and Manos were friends and had an informal business
3 relationship. Ex 2108A, page 11:13-16.

4 Bentley and Manos have known each other since the middle 1980s.
5 Ex 2035, page 8:7-9 (discovery deposition taken during the pendency of
6 *Intellectual Concepts v. Wonders of Water*, Civil Suite 2004-2675-G (14th
7 Judicial District Court, Calcasieu, Louisiana)—Caton acting *pro se*
8 questioning Bentley.

9 Bentley was aware that Manos, while at WOW, found a formulation
10 that would help prevent metal corrosion. Ex 2035, page 8:18 through
11 page 9:1.

12 The formulation is said to have contained potassium sorbate.
13 Ex 2035, page 9:6.

14 After a suggestion by Caton, Bentley agreed that it was plausible that
15 another ingredient in the formulation was methyl cellulose. Ex 2035,
16 page 9:9-15.

17 On or about 17 October 2002, Bentley flew to Lake Charles,
18 Louisiana. Ex 2108A, page 5:22 (cross).

19 Upon arriving at Lake Charles, Manos introduced Bentley to Caton at
20 a meeting in Lake Charles, Louisiana. Ex 1023, ¶ 2, page 1:5-6.

21 Bentley understood the following:

22 (1) Caton became aware that WOW had a useful product
23 that had been invented by Manos, a "managing member of
24 WOW." Ex 1023, ¶ 2a, page 1:8-12.

25 (2) Caton was having problems with the effectiveness of
26 certain preservatives Caton was using, presumably at Lumen
27 Foods. Ex 1023, ¶ 2b, page 1:14-16. In support of his

JUL 01 2010

1 testimony, Bentley refers to Ex 1024 which identifies Lumen
2 Foods as a small manufacturer of meat replacement products
3 and that "this company was plagued by periodic mold problems
4 in its leading brand despite the use of potassium sorbate for
5 mycological control. Ex 1024, page 2, under Lumen Foods. In
6 late 2002, and by employing a special variation of SG-150,
7 Lumen Foods is said to have ended *aspergillus* outbreaks.

8 Bentley recalled first seeing Ex 1024 at the beginning of the PreservX
9 era. Ex 2108A, page 27:23-24.

10 Bentley's understanding of Caton problems is based on Ex 1024 and
11 conversations with Manos. Ex 2108A, page 29:15 through page 30:7.

12 Bentley had prior dealings with Manos. Ex 1023, ¶ 2c, page 2:4

13 Bentley says he was aware of prior Manos "inventive work" based
14 on Bentley's knowledge of the Manos and Beck U.S. Patent 6,833,087.
15 Ex 1023, ¶ 2c, page 2:4-7.

16 Although Bentley had not read the patent, nevertheless Bentley is of
17 the view that the patent relates to potassium sorbate and Carbowax.
18 Ex 2108A, page 10:11-24. See also Ex 2108A, page 25:16-17 (cross)
19 ("I know it had to do with potassium sorbate and some kind of a wax.")

20 In any event, based on the inventive work, Bentley thought a
21 profitable business venture might be possible. Ex 1023, ¶ 2c, page 2:7-9.

22 According to Bentley, Manos informed Bentley of Caton's request for
23 assistance to help Caton solve his preservatives problem. Ex 1023, ¶ 2d,
24 page 2:10-14.

25 Manos invited Bentley to accompany Manos to Lake Charles.
26 Ex 1023, ¶ 2d, page 2:13-16.

1 According to Bentley, he went "as a friend and as a witness to any
2 new discoveries that ... Manos might make." Ex 1023, ¶ 2d, page 2:15-16
3 (direct); Ex 2108A, page 11:13-16 (cross). We believe that "witness to any
4 new discoveries that ... Manos might make" is probably a post-litigation
5 afterthought.

6 On or about 17 October 2002, Bentley met with Manos and Caton at
7 Lumen Foods. Ex 1023, ¶ 3, page 2:17-19.

8 Caton, Manos and Bentley went to a "back room" at "the facility".
9 The back room is referred to elsewhere in the record as the "spice" room.
10 The "spice" room is said to have included a few pieces of equipment.
11 Ex 1023, ¶ 3, page 19-20.

12 The physical nature of the Lumen Foods operation is further described
13 in connection with testimony by **Tabetha LeDoux**. Ex 2085.

14 Apparently, Manos was given some "powders" (which Bentley
15 understood to be chemicals used in the Lumen Foods business) and Bentley
16 and Manos were left alone in the room. Ex 1023, ¶ 3, page 2:20 through
17 page 3:2.

18 Bentley observed Manos formulate some "liquid concoctions."
19 Ex 1023, ¶ 3, page 3:2-4 (direct); Ex 2108A, page 7:7-9 (cross).

20 Bentley does not know "what liquid concoctions ... [Manos]
21 prepared." Ex 2108A, page 16:23-24.

22 Bentley does not know if Manos brought any chemicals when Manos
23 arrived in Lake Charles. Ex 2108A, page 8:21-24.

24 After formulating the liquid concoctions and being "satisfied", Manos
25 is said to have informed Caton. Ex 1023, ¶ 3, page 3:4-5.

26 Bentley was apparently just an observer, because he states he did not
27 participate in the experiments. Ex 2108A, page 18:19-21 (cross).

1 Caton is said to have been "surprised" at the Manos results and
2 "excited by its potential." Ex 1023, ¶ 3, page 3:6-7.

3 According to Bentley, upon Manos attempting to describe his work to
4 Caton, Caton said he had more important things to do, but Manos could
5 describe the results, etc., to John Houston—who is said to have been the
6 General Manager of Lumen Foods. Ex 1023, ¶ 5, page 8-12.

7 Further according to Bentley, Manos proceeded to "teach" Houston
8 how to prepare the "formulations" that could be used as "food
9 preservatives." Ex 1023, ¶ 5, page 3:12-14 (direct). Bentley cannot identify
10 the details of what Manos is said to have taught Houston. Ex 2108A, page
11 17:11-14 (cross).

12 At some point, Caton regained some interest in the matter, and still
13 further according to Bentley wanted to "run certain tests on the new [Manos]
14 formulations." Ex 1023, ¶ 6, page 3:15-16.

15 Bentley and Manos are said to have left Lake Charles on or about
16 19 October 2002. Ex 1023, ¶6, page 3:16-17.

17 After leaving Lake Charles, there came a time when Manos is said to
18 have informed Bentley that, while working in Lake Charles, Manos
19 "conceived" the idea of using "certain chemicals" as anticorrosive agents for
20 metals. Ex 1023, ¶ 7, page 3:20 through page 4:2.

21 Bentley later found out Caton was excited about the results on the
22 food preservatives and it was decided among Manos, Caton and Bentley for
23 form a "new venture" centered "around the multiple [Manos] inventions"
24 Ex 1023, ¶ 8, page 4:4-6. Bentley does not say how he found out that Caton
25 was excited.

26 By "multiple," Bentley means "food, wood and metal" inventions.
27 Ex 2108A, page 27:2-3.

1 Further according to Bentley, Caton is said to have said that his only
2 interest was in the business of food preservatives. Ex 1023, ¶ 8, page 4:7-8.

3 Bentley and Manos proceeded with the new venture possibly on the
4 basis that it would incorporate the field of metal anticorrosives. Ex 1023,
5 ¶ 8, page 4:8-9.

6 Bentley acknowledges that on or about 13 November 2002, Manos,
7 Caton and Bentley signed the "Letter of Intent" (Ex 1007). Ex 1023, ¶ 9,
8 page 4:10-15. Bentley's understanding of the roles of Manos, Caton and
9 Bentley is the same as the understanding Manos had of those roles.
10 Compare (1) Ex 1023, ¶¶ 9a, 9b and 9c with (2) Ex 2107A, page 30:14-21.

11 PreservX was incorporated in the State of Nevada on 13 November
12 2002. Ex 1023, ¶ 10, page 5:13-14 (Bentley direct); Ex 1016 (State of
13 Nevada corporation documents).

14 Bentley discusses the contacts with Alston & Bird and the possibility
15 of a patent application. Ex 1023, ¶ 11, page 6:3-15. Inasmuch as Bentley
16 does not appear to have personal knowledge of the events leading up to
17 filing patent application, we decline to give any weight to ¶ 11 of the
18 Bentley testimony.

19 With respect to Caton being named an inventor on the provisional
20 application, Bentley states the following: "When it came time to file the
21 [provisional] patent application, Mr. Caton insisted that he be listed as an
22 inventor or he would not pay for the [provisional] application." Ex 1023,
23 ¶ 12, page 6:19-20.

24 Based on the Bentley testimony, we get the idea that Bentley believes
25 Caton paid for some of the expenses of associated with filing a provisional
26 application. However, there came a time when Caton stopped paying.
27 Ex 1023, ¶ 13, page 7:20 through page 8:2.

1 Bentley reiterates that he personally witnessed Manos prepare
2 preservative formulations in Lake Charles, Louisiana, but does not identify
3 the composition of those formulations. Ex 1023, ¶ 14, page 8:8-10.

4 Bentley further reiterates that he discussed with Manos the results of
5 Manos subsequent tests (probably those Manos says he conducted in North
6 Carolina after returning from Lake Charles), but Bentley gives no details
7 about the tests, the formulations tested or the results of testing the
8 formulations. Ex 1023, ¶ 14, page 8:10-12.

9 There came a time when Bentley flew into Pinehurst, North Carolina
10 and on that occasion Manos is said to have shown Bentley some of the
11 results of his North Carolina experiments. Ex 2108A, page 19:1-7 (cross).
12 However, Bentley has no records of his trip to North Carolina. Ex 2108A,
13 page 19:12-13.

14 As far as Bentley is concerned, the involved Manos patent relates to
15 prevention of corrosion in metals—not foods. Ex 1023, ¶ 14, page 8:3-4.

16 Bentley goes on to say that he has no personal knowledge that Caton
17 had anything to do with an invention relating to preventing corrosion in
18 metals. Ex 1023, ¶ 15, page 8:13-14.

19 Tabetha LeDoux

20 LeDoux was employed in Lake Charles, Louisiana, by Herbologics
21 d/b/a [doing business as] Lumen Foods. Ex 2085.

22 Lumen Foods is said to have been a vegetarian products business
23 operated by Caton and his wife, Cathryn Caton. Ex 2085, page 2/15 (note
24 the top right-hand corner; the Exhibit is otherwise devoid of page numbers
25 and has no line numbers).

26 We understand LeDoux to say she worked for Caton from 2001 until
27 2007. Ex 2085, page 2/15.

1 LeDoux was "Executive Manager" for Lumen Foods and later for
2 PreservX. Ex 2085, page 2/15.

3 According to LeDoux, PreservX was in the business of producing and
4 selling different versions of preservatives that are said to have been used by
5 customers for preserving foods and metal. Ex 2085, page 2/15.

6 With respect to her responsibilities, she said the following: "I was
7 responsible for everything and anything related to the corporation side of the
8 business." Ex 2085, page 2/15.

9 LeDoux describes her job as (1) serving as office manager and
10 network technician, (2) answering phones for all the Caton businesses,
11 (3) placing orders to all outside companies, (4) interacting with customers
12 and (5) submitting orders to Houston. Ex 2085, page 2/15.

13 LeDoux says she used multiple types of business records of the
14 company on a daily basis. Ex 2085, page 2/15.

15 By way of example, LeDoux says Ex 2064, Ex 2065, Ex 2080,
16 Ex 2081, Ex 2082 and Ex 2083 "were kept in the ordinary course of business
17 for the Caton companies, including Herbologics, Lumen Foods and
18 PreservX." Ex 2085, page 2.

19 (1) Ex 2064 is a "Closing Analysis" of a product identified as
20 SG-150. The document is dated December 2002. It comes after the time the
21 invention would have been conceived by Manos or Caton and is therefore
22 irrelevant to any issue of who is the inventor. Even if admissible, it does not
23 describe the composition of SG-150 and does not say when it was conceived
24 or who conceived it.

25 (2) Ex 2065 is a "Report of Analysis" of Sample ID:
26 CD02964. The composition of CD02964 is not identified. Accordingly,
27 Ex 2065 is marginally relevant to any conception issue because it bears a

1 "Submit Date" of 28 October 2002. Even if admissible, the document is
2 entitled to little, if any, weight.

3 According to LeDoux, Caton maintained a "Goldmine" program on an
4 old DOS computer system.

5 Further according to LeDoux, Caton used to keep all his notes in
6 Goldmine.

7 LeDoux had access to Goldmine and could make entries and print out
8 files. Ex 2085, page 5/15.

9 Ex 2080 is said to be a print out from Goldmine. Ex 2085, page 5/15.
10 It purports to "discuss" entries which LeDoux invites us to find were made
11 by Caton. We decline the invitation. First, LeDoux says she could make
12 entries. We therefore do not know whether she or Caton made the entries.
13 Second, there is no entry for the critical time period. Rather, in Ex 2080
14 there is a gap from 24 September 2002 through 14 December 2002. There is
15 no entry for the Manos/Bentley October visit. We cannot find that the
16 records are authentic or complete. In any event, Ex 2080 does not address
17 when Manos or Caton made the invention.

18 LeDoux maintained certain "Caton" business websites. Ex 2085,
19 page 5/15. We are not told the significance of the websites vis-à-vis
20 conception of the invention by Manos or Caton.

21 LeDoux describes the office set-up. Ex 2085, page 6/15. Significant
22 in view the 2002 October Caton/Bentley visit is the ingredient room, a/k/a
23 the "spice room," where "things" are said to have been prepared for the
24 production line. Ex 2085, page 6/15.

25 Ex 2081 is said to be a sample of "order forms, faxes and checks paid
26 to Lumen Foods. Ex 2085, page 7/15. Ex 2081 consists of documents dated
27 2000 or earlier. The documents have nothing whatsoever to do with events

1 around the October 2002 time-frame. We decline to give Ex 2081 any
2 weight.

3 LeDoux testifies about receipt of invoices from Alston & Bird and
4 payment of those bills (Ex 2082 and Ex 2083). Ex 2085, page 8/15. The
5 invoices and bills have nothing to do with the events in the October 2002
6 time-frame. We decline to give any weight to Ex 2082 or Ex 2083.

7 LeDoux describes the role of Houston in the Caton companies.
8 Ex 2085, page 10/15.

9 Houston "would make sure that everything was being taken care of
10 ..." Ex 2085, page 10/15.

11 According to LeDoux, Houston "was usually involved in making" any
12 product based on new ideas that Caton came up with. Ex 2085, page 10/15.

13 For example, says LeDoux, "like as far as improving the properties of
14 ... PreservX." Ex 2085, page 10/15.

15 According to LeDoux, meetings between Manos and Caton "almost
16 always took place in my office." Ex 2085, page 11/15. Apparently the
17 October 2002 meeting between Caton, Bentley and Caton in the "spice"
18 room was an exception.

19 LeDoux says that she "technically" was not in on the conversations.
20 Ex 2085, page 11/15.

21 Nevertheless, she remembers a conversation between Caton, Houston,
22 a Miss Farris and Mrs. Caton about Manos coming down to Lake Charles for
23 a weekend. Ex 2085, page 12/15.

24 LeDoux was not with Manos, Caton and Bentley on the weekend
25 when Manos and Bentley came to Lake Charles. Ex 2085, page 12/15.

1 Nevertheless, she remembers being there at a time when Manos and
2 Caton were at Lumen Foods and further remembers that Manos, Caton and
3 Houston were talking about "this new preservative." Ex 2085, page 12/15.

4 She "thinks" at the time "we" were talking about metal cleaner uses.
5 Ex 2085, page 12/15.

6 LeDoux claims to have seen "a little demonstration", but she gives
7 absolutely no details about the nature of the demonstration. Ex 2085,
8 page 12/15.

9 LeDoux remembers sending some samples said to have "prepared" by
10 Caton and via UPS to be tested. Ex 2085, page 13/15. LeDoux does not
11 identify the composition of the "samples" and does not say whether the
12 composition of the "samples" differed in any respect from samples which
13 Manos had made during the Manos/Bentley visit to Lake Charles.

14 According to LeDoux, Manos and Bentley came down "another time
15 to meet with Caton and get PreservX started. Ex 2085, page 13/15. As best
16 we can surmise, the "another time" might have been when the "Letter of
17 Intent" was signed in November of 2002.

18 Caton and Houston are said to have wanted to change the "formula,"
19 but Manos and Bentley would have no part of any change. Ex 2085,
20 page 13/15.

21 LeDoux recalls Caton, Houston, and "everyone in the office" working
22 on development of a new PreservX preservation product from the October
23 2002 time-frame well into the Summer of 2003. Ex 2085, page 13/15. No
24 details about any development work are given.

25 Apart from the fact that much of the LeDoux testimony is hearsay, the
26 LeDoux testimony as a whole fails to reveal any reliable useful information

1 concerning when Manos or Caton is an inventor of the subject matter in
2 dispute. We give the testimony little, if any, weight.

3 Paul B. Grant

4 In August of 2008, **Paul B. Grant** was President of **Carmel Foods**.
5 Ex 2051, page 3/8 (like the LeDoux declaration, the pages of the Grant
6 declaration are not numbered and there are no line numbers).

7 Grant says (1) he is acquainted with Manos, Bentley, Caton and a Bill
8 Woodward and (2) remains in contact with Bentley and Woodward.
9 Ex 2051, page 3/8. We assume Grant does not remain in contact with
10 Manos.

11 Grant says he first met Caton in January of 2002. Ex 2051, page 3/8.

12 Prior to October of 2002 (but Grant does not say when), he discussed,
13 with Caton and a **Gary Harrison**, using beeswax in potassium sorbate based
14 preservatives. Ex 2051, page 3/8.

15 Caton wondered if **Flowers Baking Company** might be interested in
16 using the beeswax/potassium sorbate preservative. Ex 2051, page 3/8. At
17 this point we will observe that an electronic search of the Manos patent does
18 not reveal the word beeswax. Likewise, we have not been shown where
19 beeswax appears in the provisional application. We therefore feel that the
20 beeswax incident is entitled to little, if any, weight.

21 According to Grant, Caton and Bentley were starting a company to
22 "commercialize this new preservative." Ex 2051, page 4/8

23 After signing a non-disclosure agreement (Ex 2048) and a "Letter of
24 Intent" (Ex 2050—this letter probably is different from the "Letter of Intent"
25 previously mentioned in this opinion), Grant says he received "a sample"
26 from Caton in the first week of December of 2002. Ex 2051, page 4/8.

1 Grant has not testified about the precise composition of the "sample" and we
2 doubt he knows the composition.

3 In any event, Grant took the sample to Flowers Baking Company "so
4 they could test it." Ex 2051, page 5/8.

5 According to Grant, by June of 2003, "the process for making the new
6 preservative product was being scaled up for commercial production."
7 Ex 2051, page 5/8.

8 Grant was in "the plant" in Lake Charles "weekly" and knows that
9 Manos was never in the plant while Grant was there. Ex 2051, page 5/8.

10 Houston is said to have made the new formulation. Ex 2051,
11 page 5/8.

12 Grant understood at the time that "the preservative product"
13 (presumably the "new formulation") included propionate and
14 methylcellulose. Ex 2051, page 5/8.

15 Manos apparently called from time to time, but Caton and Grant
16 instructed Houston not to give Manos "any information." Ex 2051, page 5/8.

17 Without reference to any documentation whatsoever, Grant asserts
18 that in the November 2002 to February 2003 time-frame, Grant knew Caton
19 was also developing "the new preservative" to be used as an anti-corrosive
20 agent for metals. Ex 2051, page 6/8. In this respect, we have not been
21 favored with any reference in the Caton Goldmine entries about any Grant
22 visit to Lake Charles in the September 2002 through December 2002 time-
23 frame. Ex 2080.

24 The only folks who knew the formula of the "new preservative" are
25 said to have been Caton, Houston and Grant. Ex 2051, page 6/8.

1 Grant says, based on phone calls with Manos, that Manos "was not
2 familiar with the most basic properties of the components of the [new]
3 formulation." Ex 2051, page 6/8.

4 Grant refers to "paperwork" which "reflected" Caton as the "inventor
5 and owner of the product." Ex 2051, page 6/8. Our question is: "What
6 paperwork?" No doubt, Manos—Zannier have the same question.

7 Grant then refers to a discussion between Bentley and Grant wherein
8 Bentley is said to have asked Grant to testify that Manos was the inventor.
9 Ex 2051, page 7/8.

10 Apparently, Bentley thought Grant had said at one time that Manos
11 was the inventor. Ex 2051, page 7/8.

12 Grant disavows having said anything of the sort. Ex 2051, page 7/8.

13 The Grant testimony does not fare much better than the LeDoux
14 testimony. It is devoid of any details concerning specific formulations and
15 comes numerous years after the fact. To say that Grant has an axe to grind is
16 putting it mildly. We decline to credit the Grant testimony.

17 Jason Cooper

18 As mentioned earlier, Jason Cooper is an attorney associated with
19 Alston & Bird in North Carolina. Ex 1008, page 1. Ex 1008 is an affidavit
20 of Cooper apparently filed in Manos v. Caton in Civil Action 2:03CV2347
21 filed in the U.S. District Court for the Western District of Louisiana.

22 In the affidavit, Cooper explains how Alston & Bird came to file the
23 Manos and Caton provisional application and subsequently a Manos patent
24 application.

25 Despite initially naming Manos and Caton as inventors in the
26 provisional application, there came a time (25 June 2003) when Cooper
27 received the "Letter of Intent" "which made ... [Cooper] question whether

1 ... Caton has been mistakenly named as an inventor and whether ... Manos
2 was actually the solve inventor of the invention claimed in the provisional
3 application." Ex 1008.

4 The Cooper affidavit is dated 23 June 2004 (Ex 1008, page 5), which
5 is just prior to the filing on 26 June 2003 of the Manos patent application.

6 Testimony of Cooper (Ex 2019A; Ex 2098A) in this proceeding took
7 place by deposition. Only portions of the testimony have been presented.

8 After acknowledging that he spoke with both Manos and Caton,
9 Cooper states that his initial assignment was to draft a patent application for
10 PreservX (Ex 2019A, page 5:2-16), Alston & Bird having been retained by
11 PreservX (Ex 2022, pages 2-3 [retainer agreement dated 21 November
12 2002]).

13 Melissa Pendleton, who is familiar with chemistry, was assisting in
14 preparation of the patent application. Ex 2019A, page 6:2; Ex 2098A,
15 page 4:5-13.

16 Cooper was called as a witness by Caton—Intellectual Concepts to try
17 to establish that Caton, not Manos, was the "sole" inventor. In this respect,
18 Cooper was questioned about a series of handwritten notes. In general, we
19 find that the notes establish little, if anything, about who made the invention.

20 For example, Cooper discusses a series of e-mails between Cooper
21 and Caton. Ex 2098A, page 7 (as numbered at the bottom), line 21 through
22 page 10:21. The emails appear in Ex 2022, on unnumbered pages 6-7.

23 A first email (dated 10 December 2002 at 2:25 p.m.) appears to be
24 transmitting to information about a patent that was found on an on-line
25 search. Ex 2002, page 5. Cooper said to Caton: "it would be good if you
26 guys could review this patent and provide your comments as to the impact
27 you think it has on your invention." Ex 2022, page 5.

1 Caton responded (Ex 2022, 6th page) (emphasis and bracketed matter
2 added):

3 I went over the enclosed patent and didn't find any
4 relationship between it and what we are doing other than their
5 proposed use of proprionic [sic—propionic] acid or its salt for
6 the well-drilling application. What is central to our invention,
7 and how it differs from 6,248,700 [presumably the patent to
8 which Cooper made reference in the earlier email] *is that the*
9 *use of the methylcellulose brings out properties that are not*
10 *inherent to proprionic* [sic—propionic] *acid*, used by itself, and
11 certain not evidence in the patent you cite.

12 We should be able to proceed without fear of interfering
13 with this patent.

14 Cooper replied in part (Ex 2002, 6th page):

15 Thanks for your comments. The methylcellulose aspect
16 is not something we had considered, and I think it would be
17 best if someone at your end would write up an invention
18 disclosure so that we can get a handle on exactly what the
19 invention is. For example, how does the methylcellulose
20 interact with proprionic [sic—propionic] acid, and what
21 properties are enhanced by the interaction?

22 Caton—Intellectual Concepts views certain "notes" (Ex 2021) made
23 by Cooper as significant. We do not think they amount to much.

24 The "big deal" as far as Caton—Intellectual Concepts is concerned is
25 the notes on unnumbered page 3 of Ex 2021 bearing a "1/29/03" date in the
26 upper left-hand corner. The notes appear to be from a telephone conference
27 involving Cooper and Caton (Ex 2098A, page 23:23-24) that took place on

1 "1/29/03" (Ex 2098A, page 23:1) which we take to mean 29 January 2003.

2 See also Ex 2098A, page 25:15-18 (at the top of the page).

3 Among other things and according to Cooper, the notes say at least
4 the following.

5 (1) Robert Bentley, CEO, supports Dave Manos. Ex 2098A,
6 page 24:19.

7 (2) salts of propionic acid and benzoic acid is a organoleptic
8 stabilizer. Ex 2098A, page 23:4-6.

9 (3) "keep Dave Manos out of the picture. Greg Caton ~~is the~~
10 ~~inventor~~ ... don't talk to Dave Manos any more." Ex 2098A,
11 page 24:3-6. The strikeout is present because "is the inventor"
12 is crossed out in the notes. As Cooper says it: "but then
13 somebody scratched that ["is the inventor"] out." Ex 2098A,
14 page 24:4-5. Cooper does not know who scratched out the "is
15 the inventor."

16 (4) He [Caton and his associates] doesn't mind paying 15 to
17 20K down the road. Ex 2098A, page 24:6-7.

18 A possible inference from the notes is that Cooper may have smelled a
19 rat, i.e., a dispute between Bentley/Manos on the one hand and Caton on the
20 other hand and therefore may have decided to look into who actually was the
21 "real" inventor.

22 Melissa Pendleton

23 Melissa Pendleton was called as a witness by Caton—Intellectual
24 Concepts. Ex 1009 and Ex 2100A.

25 Ex 1009 (at least the portions we have been given) has no information
26 relevant to who conceived the invention.

1 Pendleton was at all times relevant to this case a patent attorney
2 (Ex 1009, page 4:22). Other evidence in the record establishes that she was
3 associated with Alston & Bird. See, e.g., Ex 2100A, page 52:24.

4 Pendleton states that she received a fax (Ex 2024) from Manos on or
5 about 12 February 2003. Ex 2100A, page 52:12.

6 She probably requested the information contained in the fax.
7 Ex 2100A, page 53:12-14.

8 Pendleton does not recall having a conversation with Manos about the
9 fax. Ex 2100A, page 53:3-6.

10 Caton—Intellectual Concepts made an attempt to find out how
11 Pendleton used the fax in the preparation of the application. Ex 2100A,
12 page 53:15 through page 54:1; page 55:20-21. The attempt was an improper
13 invasion into work product. The objection to the admissibility of the
14 evidence based on work product is sustained and we will give no weight
15 whatsoever to the manner in which Pendleton might have used the fax. *In re*
16 *Seagate Technology, LLC*, 497 F.3d 1360 (Fed. Cir. 2007) (en banc); *In re*
17 *Spalding Sports Worldwide, Inc.*, 203 F.3d 800 (Fed. Cir. 2000).

18 Pendleton also states that she received a second fax (Ex 2023) from
19 Manos on or about 12 February 2003. Ex 2100A, page 59:2-7.

20 The "title" of the document is "Technical Overview of RP-20".
21 Ex 2023, page 3.

22 When asked if she recalled "what Rp-20 is", Pendleton answered
23 "No." Ex 2100A, page 59:22-23. We are not at all surprised by the answer.

24 When asked if she called Manos about the second fax, Pendleton said
25 she could not recall. Ex 2100A, page 60:12-16.

26 Pendleton was questioned about unnumbered page 4 of Ex 2021. The
27 page bears "2/19/03" at the top.

1 The handwriting is in Pendleton's and refers to a telephone
2 conversation with Caton. Ex 2100A, page 60:21 through page 61:1.

3 The notes are said to summarize the Caton telephone conversation, it
4 being Pendleton's practice to take notes during telephone conversations.
5 Ex 2100A, page 61:2-6.

6 Pendleton does not recall using the notes in preparing a patent
7 application (Ex 2100A, page 61:7-10); in any event, Caton—Intellectual
8 Concepts is not entitled to know whether she did.

9 If there is one witness in this case who can be believed, it is
10 Pendleton. Unfortunately for Caton—Intellectual Concepts, her testimony
11 has little to do with who made the invention claimed in the Manos patent or
12 the Caton application.

13 The provisional application and Manos patent

14 While we have not been favored with a word-by-word comparison of
15 the descriptive portion of the Manos and Caton provisional application and
16 the Manos patent, both appear to be essentially the same.

17 The claims of the Manos and Caton provisional application and the
18 Manos patent are different and are discussed later on in this opinion.

19 In describing the invention, quoted material is from the patent.

20 The invention "is directed to preventing the oxidative corrosion of
21 metal surfaces." Ex 2043, col 2:20-21.

22 More particularly, the invention involves exposure of metal to an
23 "anti-corrosion agent" (also referred to as an ACA) "characterized as a lower
24 alkyl carboxylic acid, an alkali salt, or other derivative thereof ..." Ex 2043,
25 col. 2:23-24.

26 "Advantageously the...ACA is one having food-grade GRAS
27 (generally recognized as safe)-status under U.S. Food and Drug

1 Administration guidelines; or (2) an acceptable safety status under the aegis
2 of the United States Pharmacopeia (USP)/National Formulary (NF)
3 guidelines for human exposure. The ACA is therefore safe for use in food
4 and beverages, and other ingestible products, as well as in products
5 associated with foods and beverages. Such ACA agents are suitable for use
6 by and on humans and animals. One such ingestible ACA is sodium
7 propionate." Ex 2043, col. 2:27-37.

8 The ACA can be used alone or in combination with other compounds,
9 including other anti-corrosion agents known in the art. Other agents,
10 including any additional anti-corrosion agents, can also be ingestible.
11 Particularly useful ingestible anti-corrosion agents include 2,4-hexadienoic
12 acid and alkali salts and/or other derivatives thereof. Another useful
13 compound for use in combination with the ACA is benzoic acid and alkali
14 salts and/or other derivatives thereof. Ex 2043, col. 2:38-49.

15 "The ACA can also be used in combination with a material capable of
16 forming a moisture retentive barrier on the surface of the metal. In certain
17 applications, the anti-corrosion agent alone is sufficient to achieve the
18 desired anti-corrosive effect." Ex 2043, col. 2:50-54.

19 We have found no mention of beeswax, a material which is said to
20 have been of interest to Caton. Ex 2051, page 3/8.

21 "The material capable of forming a moisture retentive barrier film
22 over a surface of the metal is selected from the group consisting of a polar
23 liquid, a non-polar liquid, a viscous material, an organic liquid, a polymeric
24 material and a petroleum-based substance, as well as combinations thereof."
25 Ex 2043, col. 2:55-60.

26 The invention is said to provide "a practical, non-toxic method that
27 ensures anti-corrosion protection for metals, or devices containing exposed

1 metals, stored or operated in water or in the presence of water vapor."

2 Ex 2043, col. 3:54-57.

3 "[ACA] compositions that include the lower alkyl carboxylic acid
4 moiety can inhibit the corrosion of metals for indefinite periods of time in a
5 variety of venues as hereinafter described, e.g., while the metals remain
6 immersed in an ACA solution, following coating with ACA in combination
7 with other viscous agents or otherwise jacketed in ACA by a moisture
8 retentive barrier." Ex 2043, col. 3:57-63.

9 The lower alkyl carboxylic acid moiety can be derived from a C₁-C₆
10 carboxylic acid, or from a salt or other derivative thereof, including, e.g.,
11 propionic acid, as well as lower alkyl carboxylate salts, e.g., propionates.
12 Ex 2043, col. 3:64 through col. 4:9.

13 One exemplary lower alkyl carboxylate useful in the invention is
14 sodium propionate. Ex 2043, col. 4:16-17.

15 "The ACA can be used alone or in combination with other
16 compounds, including other anti-corrosion agents as known in the art."
17 Other agents can be ingestible. "Particularly useful ingestible anti-corrosion
18 agents include compounds that conserve or embody a 2,4-trans, trans-
19 hexadiene moiety in their molecular structure", such as potassium sorbate.
20 Ex 2043, col. 4:26-36.

21 "Other compounds useful in combination with the ACA of the
22 invention include acids and/or salts or other derivatives thereof that are
23 capable of increasing the solubility of the ACA in water. The compound
24 capable of increasing the solubility of the ACA in water is also
25 advantageously ingestible..." One example of such a compound is benzoic
26 acid and its alkali salts, such as sodium benzoate. Ex 2043, col. 4:40-48.

1 As noted earlier, the ACA may be used in combination with a
2 moisture barrier. Ex 2043, col. 2:50-54.

3 One preferred embodiment centers upon admixture of the ACA with
4 various materials including to homogenous or heterogeneous polymers of
5 amino acids including methyl cellulose, ethyl cellulose, methyl ethyl
6 cellulose, as well as mixtures thereof. Ex 2043, col. 11:3-36, and see in
7 particular, col. 11:26.

8 The compositions according to the invention are said to prevent the
9 corrosion of various types of stainless steel, various types of low carbon
10 steel, as well as cast iron, aluminum and other metals. Ex 2043,
11 col. 12:25-28.

12 Other uses are said to include treating wood for termite control or
13 reduction of brown mold and mixing the ACA with animal feeds for mold
14 prevention and odor reduction. Ex 2043, col. 13:36-39.

15 Still other uses are said to include use of the ACA in methods of
16 preparing food and/or beverage preservatives. An ingestible
17 ACA, a lower alkyl carboxylic acid moiety is combined with a suitable food
18 grade polymer. Ex 2043, col. 14:45-48. Suitable food grade polymers
19 include cellulose and cellulose derivatives. Ex 2043, col. 14:48-51. See
20 also Ex 2107A, page 14:10-21 (Manos cross) where he discusses hydration.

21 "Regardless of the ingestible [ACA] used, the 'inventors' have found
22 that the order of addition of the compounds [ACA and polymer] comprising
23 the food preservative can impact the properties of the resultant composition.
24 For example, a food grade polymer, such as cellulose,...is added to an
25 aqueous solution under conditions sufficient to hydrate or saturate the
26 polymer component." Ex 2043, col. 14:60 through col. 15:1.

1 The Manos patent, like the Manos and Caton provisional application
2 (Ex 2001, page 21:15) refer to the "inventors." But, the Manos patent names
3 only one inventor. We will assume that in proof-reading the Manos
4 application the attorneys missed the "inventors" when filing the Manos
5 application. Apparently, Manos also missed the reference to "inventors."

6 Getting back to the disclosure, hydration conditions may need to be
7 varied depending upon the nature of the polymer, the amount of polymer
8 used, and "can be determined readily by the skilled artisan." Ex 2043,
9 col. 15:6-8.

10 The hydrated solution can be evaluated qualitatively by visual
11 observation to determine if the polymer is substantially completely dissolved
12 into solution. The amount of polymer added to solution can vary and
13 generally ranges from about 0.01 up to about 20 weight percent, although
14 amounts outside of this range may also be useful so long as the polymer is
15 sufficiently dissolved in the solution. The skilled artisan is said to be able to
16 appreciate that the amount of polymer used can depend at least in part on the
17 size of the polymer. The "inventors" have found that this aspect of the
18 invention is useful with polymers ranging widely in size, as determined by
19 variations in polymer chain length, molecular weight (as low as 200 up to
20 8000 or more), and viscosities. Ex 2043, col. 15:9-22.

21 Thereafter, the ingestible anti-corrosion agent is added to the hydrated
22 polymer to form a preservation composition. Ex 2043, col. 15:33-34.

23 The ingestible ACA agent is added to the hydrated polymer in an
24 amount sufficient to allow formulation of a composition therefrom that
25 exhibits preservative properties when used in connection with food and/or
26 beverage products. As little as 0.2 weight percent of the ACA, based on the

1 weight of the composition as applied to the food and/or beverage product, is
2 said can be effective as a mold inhibitor. Ex 2043, col. 15:26-36.

3 In addition to its effectiveness as an anti-microbial agent, the food
4 preservative is said to impart "organoleptic stability" to the food or
5 beverage to which it is applied. Organoleptic stability refers to the stability
6 of the food and/or beverage over time, and in particular to sensory attributes
7 such as smell and taste exhibited by such foods/beverages over time as
8 determined using known qualitative test standards. Ex 2043, col. 16:7-14.
9 It will be recalled, that Caton supposedly told Cooper about "organoleptic
10 stability." Ex 2098A, page 23:4-6.

11 The Caton application

12 The Caton application (Ex 2038) is discussed only because it, unlike
13 the Manos application, has examples. We discuss the example because we
14 think it helps understand the nature of the invention.

15 EXAMPLE I

16 In a tank capable of mixing 1000 gallons of liquid, add 300
17 gallons of purified water. Then add 12 lbs of methylcellulose and
18 blend this mixture (i.e., water and methylcellulose) for 5 minutes.
19 Next, add 200 gallons of purified water and 751.60 lbs. of sodium
20 propionate. While blending this mixture (i.e., water, methylcellulose
21 and sodium propionate), add 100 gallons of purified water and then
22 382.64 lbs of sodium benzoate. Then, add 1365.94 lbs. of sodium
23 benzoate and, finally, 220 gallons of purified water; mix for 1 hour.
24 Transfer the entire batch to a cooling tank and mix constantly until the
25 mixture has cooled. From the beginning of the process until the batch
26 cools, the mixture is to be continually mixed. Ex. 2038, page 30:21
27 through page 21:2.

1 The Manos and Caton provisional application claims

2 Since inventorship is determined based on claims, we bring up at the
3 outset that the claims of the Manos and Caton provisional application are
4 different from the claims of the Manos patent.

5 Manos/Canton Provisional Application Claims

6 Independent claim 1 is directed to preventing oxidative corrosion of a
7 *metal*. Ex 2001, page 24.

8 Independent claim 29 is directed to preventing oxidative corrosion of
9 a *metal*. Ex 2001, page 27.

10 Independent claim 31 is directed to preventing oxidative degradation
11 of a *substance*. Ex 2001, page 27. Dependent claim 31 reveals that the
12 substance can be a "grain product. Ex 2001, page 27.

13 Independent claim 35 relates to preventing oxidative corrosion of a
14 *metal*. Ex 2001, page 27.

15 Independent claim 60 relates to preventing oxidative corrosion of a
16 *metal*. Ex 2001, page 27.

17 Independent claim 70 relates to preparing a *food/beverage*
18 *preservative*. Ex 2001, page 31.

19 The Manos patent claims

20 Independent claim 1 relates to a method of preventing oxidative
21 corrosion of a *metal* applying an ACA and "optionally" a moisture retentive
22 barrier. Ex 2043, col. 16.

23 Independent claim 15 relates to a method of preventing oxidative
24 corrosion of a *metal* applying an ACA and "optionally" a moisture retentive
25 barrier. Ex 2043, col. 17.

1 Independent claim 17 relates to a method of preventing oxidative
2 corrosion of a *metal* applying an ACA and "optionally" a moisture retentive
3 barrier. Ex 2043, col. 17.

4 Independent claim 24 relates to a method of preventing oxidative
5 corrosion of a *metal* applying an ACA and "optionally" a moisture retentive
6 barrier. Ex 2043, col. 18.

7 Independent claim 25 relates to a method of preventing oxidative
8 corrosion of a *metal* applying an ACA and "optionally" a moisture retentive
9 barrier. Ex 2043, col. 18.

10 Independent claim 26 relates to a method of preventing oxidative
11 corrosion of a *metal* applying an ACA and "optionally" a moisture retentive
12 barrier. Ex 2043, col. 18.

13 All the claims of the Manos patent relate to prevention of corrosion in
14 a *metal*.

15 Credibility findings

16 Neither Manor nor Caton are particularly credible witnesses.

17 On a scale of 0 to 100, Manos is no more than a 9.

18 Caton barely makes it to a 2.

19 Accordingly, to the extent there is a conflict between the testimony of
20 Manos and that of Caton, we credit the Manos testimony.

21 One reason we believe Manos more than Caton is that the Manos
22 "story, confirmed somewhat by Caton and Bentley, is more consistent with
23 what ended up in the patent than the Caton "story."

24 Bentley was not much better than Manos or Caton and maybe
25 rates a 6.

26 To the extent there is a conflict in the testimony of Bentley and that of
27 Caton, we credit the Bentley testimony.

1 LeDoux and Grant are barely believable.

2 LeDoux gets a rating of 0.

3 Grant really has nothing important to contribute to the matter of
4 inventorship.

5 Grant also gets a 0.

6 We have no reason to doubt Cooper's testimony.

7 We credit Pendleton's testimony. She is the only witness with no axe
8 to grind in the case.

9 Narrative

10 While the evidence leaves a lot to be desired, after consideration of
11 the case—including credibility assessments—our informed finding of what
12 probably happened is the following.

13 Manos worked with corrosion prevention of metals at WOW.

14 WOW had a product it sold as RP-20.

15 It probably was made of (1) potassium sorbate, (2) polyethylene
16 glycol 8000 and (3) water.

17 WOW came on hard times.

18 Manos needed to find a means to make some money.

19 Caton was in the food business at Lumen Foods in Lake Charles,
20 Louisiana.

21 Caton was having some mold issues with some of his food products
22 and needed to get rid of the mold—the sooner the better.

23 Manos says Caton called him to come to Lake Charles and help Caton
24 solve the problem. Caton says Manos called him and asked him to come to
25 Lake Charles to solve the problem. It does not matter who made the call.

26 Manos went to Lake Charles looking for a business opportunity.

27 Manos had been friends with Bentley for some time.

1 Manos, Bentley or both Manos and Bentley saw a chance to make
2 some money.

3 Upon arrival at Lumen Foods, Manos, Bentley and Caton met in a
4 "spice" room to briefly discuss the situation.

5 At the time, Caton was using (1) sodium propionate, (2) sodium
6 benzoate, (3) potassium sorbate or (4) mixtures thereof as a food
7 preservative material. The compounds were probably mixed in water.

8 Manos brought some methylcellulose to Lake Charles.

9 Caton gave Manos some chemicals Lumen Foods was using to
10 prevent degradation of foods—i.e., mold. The trouble is that the chemicals
11 "were not working."

12 After the brief meeting to discuss the situation and after giving Manos
13 the chemicals, Caton indicated that he had better things to do and departed
14 the spice room leaving Manos and Bentley to figure out how to solve the
15 problem.

16 It is not apparent that Bentley was much help to Manos, but he
17 remained with Manos.

18 At some point, Manos came up with a preservative made from a
19 mixture of (A) a compound selected from the group consisting of
20 (1) sodium propionate, (2) sodium benzoate, (3) potassium sorbate or
21 (4) a mixture thereof, all of which were given to Manos by Caton, and
22 (B) methylcellulose.

23 At Lake Charles, Manos says he came up with the idea of adding
24 methylcellulose to ingredients which Caton was otherwise using to come up
25 with a composition—which Bentley calls a "concoction."

26 Upon adding the ingredients and coming up with the composition,
27 Manos believed he had solved the mold problem.

1 Manos also figured out that it would better if the methylcellulose was
2 hydrated prior to adding the chemicals.

3 Manos, in front of Bentley, communicated his "findings" to Caton.

4 Bentley says Caton was "excited" about the Manos findings. Caton,
5 of course, has denied any "excitement."

6 At the same time, Manos figured out that the composition would be
7 useful to prevent corrosion of metals.

8 Manos went back to North Carolina from whence he had come and
9 did more experiments on metal.

10 Ultimately, Manos, Caton and Bentley decided there was some money
11 to be made and agreed to form a "company" known in this record as
12 PreservX.

13 A "Letter of Intent" identifies Manos as inventor, Caton as
14 manufacturer, and Bentley as investor, i.e., the money man.

15 A patent application seemed like a good idea.

16 "They" retained Alston & Bird to file the patent application.

17 The patent process started with a provisional application.

18 The provisional application, which is never examined on the merits,
19 claimed methods of treating metal and what can be characterized as
20 methods of treating food products to prevent corrosion.

21 The provisional application named Manos and Caton as inventors.

22 In due course, a follow-up Manos patent application was filed.

23 Manos was named as the sole inventor.

24 A patent eventually issued to Manos.

25 The Manos patent claims a method of treating metals to prevent
26 corrosion, and does not claim a method of preserving food.

1 The patent also describes hydrating "polymers" used in making
2 suitable compositions.

3 The idea to hydrate came from Manos.

4 The idea to add methylcellulose came from Manos

5 Caton, who was in communications with Alston & Bird,
6 acknowledges that adding the methylcellulose is an important feature which
7 Caton says distinguishes (1) the compositions used in the method claimed
8 in the Manos patent from (2) those described in a patent found in a search
9 by Alston & Bird.

10 **G. Discussion**

11 Introduction

12 Manos and Caton each signed an oath that they are the "original, first
13 and sole" inventors.

14 Once a patent has issued, there is a presumption that the patentee
15 (Manos in this case) is the inventor of the subject matter claimed in the
16 patent. *Seymour v. Osbourne*, 11 Wall. (78 U.S.) 516, 538 (1870). The
17 same is true of an applicant. 35 U.S.C. § 102(f): "A person [Caton in this
18 case] shall be entitled to a patent unless:--(f) he did not himself invent the
19 subject matter sought to be patented."

20 A party seeking to change the *status quo* in an interference bears the
21 burden of proof. 37 C.F.R. § 41.121(b) (2008).

22 Resolution of inventorship

23 Inventorship is a question of law. *Acromed Corp. v. Sofamor Danek*
24 *Group, Inc.*, 253 F.3d 1371, 1378 (Fed. Cir. 2001).

25 Nevertheless, the inventorship question of law manifestly turns on the
26 facts of a particular case.

1 The facts are set out above. Based on those facts, and our assessment
2 of the credibility of the various witnesses, we believe Manos has overcome
3 the presumption that Caton is an inventor. We also believe that Caton has
4 NOT overcome the presumption that Manos is an inventor.

5 To be sure, the character and nature of the evidence in this case is not
6 what we normally see in most of our interferences. However, despite its
7 manifest shortcomings and based on the evidence, as a whole, we think that
8 Manos has the better of it.

9 Caton was having a problem. He invited Manos to Lake Charles to
10 solve it. From what we can gather from the evidence, Manos solved the
11 problem by adding methylcellulose to chemicals previously used by Caton
12 as a food preservative. Caton was in the food business—not the metal
13 preservation business. Manos had worked in the metal preservation
14 business for some time. There is no believable evidence that Caton had any
15 significant interest in metal preservation until (1) after Caton found out that
16 Manos was thinking about using the food preservation composition as a
17 metal preservative and (2) Caton felt there was some money to be made in
18 the metal preservation business. We do not think Caton would have "let it
19 go" in the "Letter of Invent" that Manos is the inventor and Caton the
20 manufacturer if Caton at that time felt he was an inventor.

21 While the testimony is not as clear as it might have been, the
22 hydration process which Manos developed with Bentley present (although
23 we doubt that Bentley fully understood hydration), appears in the
24 provisional application and the Manos patent. Caton has never claimed to
25 have come up with hydration.

26 The Manos independent patent claims are peculiar. They call for
27 preserving metal using (1) a composition of chemicals or (2) optionally a

1 mixture of a composition of chemicals in combination with a moisture
2 barrier. In effect, the independent claims are a hybrid of (1) an independent
3 claims in combination with (2) a dependent claims—the optional part. We
4 voice no opinion whatsoever on whether the independent claims are proper
5 claims.

6 Caton, of course, argues that he gave Manos the chemicals. Therefore
7 he must be an inventor. Wrong! While Caton may have used the chemicals
8 (as well as possible mixtures thereof) to preserve food, it was Manos who
9 invented use of the chemicals as metal preservatives. In effect, Manos
10 invented a second use of an old composition that already was known for a
11 first use.

12 Caton—Intellectual Concepts arguments

13 Prior to addressing specific Caton—Intellectual Concepts arguments,
14 we will indicate our agreement with the following observation in Manos—
15 Zannier Opposition 2 (Paper 68, page 2:1-4):

16 Party Intellectual Concepts has, in its Motion 2, presented a
17 document of attorney opinion peppered with, at best,
18 marginally relevant facts, none of which establish conception of
19 the invention in the claims of the count by Mr. Caton.

20
21 Caton—Intellectual Concepts relies on the testimony of LeDoux.
22 Paper 70, page 5:10. We have declined to credit the LeDoux testimony and
23 therefore it is little avail to Caton—Intellectual Concepts.

24 We are told that Caton was using potassium sorbate, sodium benzoate
25 and sodium propionate in his food preservatives. Paper 70, page 6:11-12.
26 But, use of these chemicals in food preservatives is not use of the chemicals
27 as a metal preservative.

1 Caton is said to have looked into beeswax. Paper 70, page 7:11. In
2 particular, it is said that Caton had a beeswax discussion with Cooper during
3 the preparation of the provisional application phase. But, the relevance of
4 beeswax is questionable. One also has to ask: if it was such a "big deal"
5 why is there no discussion of beeswax in the provisional application? The
6 beeswax appears to be a post-litigation afterthought.

7 According to the motion, Caton prepared some samples right after
8 Manos left Lake Charles and had those samples sent off via UPS for testing.
9 Paper 70, page 9:6-9. The LeDoux "evidence" in support of the argument is
10 based in large measure on hearsay. Moreover, the "evidence" fails to state
11 whether the Caton samples were different from those prepared by Manos
12 while Manos was in Lake Charles. One permissible inference is that
13 Caton—or maybe Houston—"copied" what Manos had already done and
14 sent the copied samples for testing. Another permissible inference is that
15 Caton sent the Manos-prepared compositions for testing.

16 Caton—Intellectual Concepts attempts to make much of the fact that
17 the Cooper telephone notes indicate that Cooper is to "[k]eep Dave Manos
18 out of the picture" and that Greg Caton is the inventor, but then somebody
19 scratched that out. It also says "Don't talk to Dave Manos any more."
20 Paper 70, page 11:7 through page 12:14; Ex 2098A, page 24:3-6. According
21 to Caton—Intellectual Concepts, "[t]hese notes appear to indicate on their
22 face that Greg Caton stated to Mr. Cooper that he was the inventor and
23 Mr. Cooper should not communicate with Dave Manos." Paper 70,
24 page 12:7-9. The motion expresses a "wish" not a "fact." For example, the
25 motions fails to recognize that Cooper says he does not know how the phrase
26 "is the inventor" came to be crossed out.

1 The motion also notes that Caton told Cooper that the "concoction," to
2 use Bentley's words, serves as "an organoleptic stabilizer." Paper 70,
3 page 12:13. It is also true that the language organoleptic stabilizer appears
4 in the provisional application. But, the significance of this fact escapes us.
5 Is the "organoleptic" property of the composition an inherent property of the
6 compositions made by Manos at Lake Charles? What did Caton contribute
7 to make the compositions "organoleptic"?

8 The motion relies on a conversation between Caton and a Mark
9 Westbrook. Paper 70, page 14:7-8. Caton has not discussed the
10 conversation. Westbrook did not testify. Any reference by LeDoux to what
11 took place during the alleged conversation is hearsay. The Caton/Westbrook
12 conversation is of no help to Caton—Intellectual Concepts.

13 Caton—Intellectual Concepts made the argument that "[a]
14 contribution of information in the prior art cannot give rise to joint
15 inventorship because it is a contribution to conception." Paper 70,
16 page 17:19-20. There is no legitimate joint inventorship in this case. The
17 inventor of the subject matter claims in the Manos patent is Manos.
18 Moreover, when an individual makes an invention the individual almost
19 always uses prior art process steps or prior art compositions. That is what
20 Manos did here. Manos used a known composition for a new use. Use of a
21 known composition for a new use is a classic type of invention. 35 U.S.C.
22 § 101.

23 The motion also tries to make something out of the fact that Manos is
24 said to have known nothing about how the propionic anion works in context.
25 Insofar as we know, there is no requirement that an inventor has to know
26 why an invention works. *Diamond Rubber Co. v. Consolidated Rubber Tire*

1 Co., 220 U.S. 428 (1911). All that is important is that the invention is
2 useful.

3 We have considered all of the arguments made in the Motion 2 and
4 Reply 2, but find that none are convincing. Cf. *Hartman v. Nicholson*, 483
5 F.3d 1311, 1315 (Fed. Cir. 2007). We also refer the reader to Opposition 2
6 for responses by Manos—Zannier to arguments made by Caton—
7 Intellectual Concepts which we have not specifically addressed. Suffice it to
8 say, we agree with the Manos—Zannier responses to many of those
9 arguments.

10 **H. Order**

11 Upon consideration of the record, and for the reasons given, it is

12 **ORDERED** that Caton—Intellectual Concepts Miscellaneous
13 Motion 8 (Paper 76) is *dismissed* as untimely filed.

14 **FURTHER ORDERED** that Manos—Zannier Miscellaneous
15 Motion 3 (Paper 75) is *dismissed* without prejudice in the event of further
16 proceedings in this case.

17 **FURTHER ORDERED** that Caton—Intellectual Concepts
18 Motion 2 (Paper 70) is *denied*.

19 **FURTHER ORDERED** that Manos—Zannier Motion 1
20 (Paper 57) is *granted*.

21 **FURTHER ORDERED** that judgment appears in a separate
22 paper entered concurrently herewith.

RECEIVED
JUL 08 2010
OFFICE OF PETITIONS

1 105,617
2 cc (via electronic mail):
3
4 Attorney for Caton
5 (real party in interest Intellectual Concepts, LLC):
6
7 Holliday C. Heine, Esq.
8 Thomas O. Hoover, Esq.
9 WEINGARTEN, SCHURGIN, GAGNEBIN & LEOVICI LLP
10 Ten Post Office Square
11 Boston, MA 02109
12
13 Tel: 617-542-2290, ext. 313
14 Tel: 617-542-2290, ext. 323
15 Fax: 617-451-0313
16 Email: HHeine@wsglip.com
17 Email: THoover@wsglip.com
18
19 Attorney for Manos
20 (real party in interest Zannier, Inc.):
21
22 Ryan Cagle, Esq.
23 Murray Spruill, Esq.
24 ALSTON & BIRD LLP
25 3201 Beechleaf Court
26 Suite 600
27 Raleigh, NC 27604-1062
28
29 Tel: 919-862-2200
30 Fax: 919-862-2260
31 Email: ryan.cagle@alston.com
32 Email: murray.spruill@alston.com
33

RECEIVED
CENTRAL FAX CENTER

JUL 01 2010

1 BoxInterferences@uspto.gov
2 Telephone: 571-272-4683

Paper 88
Entered: 23 February 2009

3
4 UNITED STATES PATENT AND TRADEMARK OFFICE
5 BOARD OF PATENT APPEALS AND INTERFERENCES
6

7
8 Patent Interference 105,617 McK
9 Technology Center 1700
10

11
12 INTELLECTUAL CONCEPTS, LLC,
13 (Named Inventor: Gregory James Caton)
14

15 Application 10/782,405,
16 Junior Party,
17

18 v.
19

20 ZANNIER, INC.,
21 (Named Inventor: Paul D. Manos)
22

23 Patent 7,264,847 B2,
24 Senior Party,
25

26
27 Before: JAMES T. MOORE, *Vice Chief Administrative Patent Judge*,
28 FRED E. McKELVEY, *Senior Administrative Patent Judge*, and
29 RICHARD E. SCHAFER, *Administrative Patent Judge*.
30

31 McKELVEY, *Senior Administrative Patent Judge*.
32

33 JUDGMENT

34 For the reasons given in the MEMORANDUM OPINION and
35 ORDER entered concurrently herewith (Paper 87), it is

RECEIVED

JUL 08 2010
OFFICE OF PETITIONS

RECEIVED
CENTRAL FAX CENTER

JUL 01 2010

1 **ORDERED** that judgment on inventorship as to Count 1
2 (the sole count in the interference; Paper 1, page 7) is awarded against Junior
3 Party Intellectual Concepts, LLC, and Gregory James Caton.

4 **FURTHER ORDERED** that neither Intellectual
5 Concepts, LLC, nor Gregory James Caton are not entitled to a patent
6 containing claims 2, 4-15, 17-28 or 30 (corresponding to Count 1) of:

7 application 10/782,405
8 filed 19 February 2004
9

10 **FURTHER ORDERED** that claims 2, 4-15, 17-28 and 30 of
11 application 10/782,405 are finally refused. 35 U.S.C. § 135(a).

12 **FURTHER ORDERED** that if there is a settlement agreement,
13 attention is directed to 35 U.S.C. § 135(c).

14 **FURTHER ORDERED** that a copy of this JUDGMENT shall
15 be placed in the files of (1) Caton application 10/782,405 and (2) Manos
16 U.S. Patent 7,264,847 B2.

RECEIVED
JUL 08 2010
OFFICE OF PETITIONS

JUL 01 2010

RECEIVED

JUL 08 2010

OFFICE OF PETITIONS

1 105,617
2 cc (via electronic mail):
3
4 Attorney for Caton
5 (real party in interest Intellectual Concepts, LLC):
6
7 Holliday C. Heine, Esq.
8 Thomas O. Hoover, Esq.
9 WEINGARTEN, SCHURGIN, GAGNEBIN & LEOVICI LLP
10 Ten Post Office Square
11 Boston, MA 02109
12
13 Tel: 617-542-2290, ext. 313
14 Tel: 617-542-2290, ext. 323
15 Fax: 617-451-0313
16 Email: HHeine@wsglip.com
17 Email: THoover@wsglip.com
18
19 Attorney for Manos
20 (real party in interest Zannier, Inc.):
21
22 Ryan Cagle, Esq.
23 Murray Spruill, Esq.
24 ALSTON & BIRD LLP
25 3201 Beechleaf Court
26 Suite 600
27 Raleigh, NC 27604-1062
28
29 Tel: 919-862-2200
30 Fax: 919-862-2260
31 Email: ryan.cagle@alston.com
32 Email: murray.spruill@alston.com
33